115-87 496

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1884.

No. 1242.

JOHN A. WOLLENSAK, APPELLANT,

vs.

FRANK A. REIHER.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF ILLINOIS.

FILED DECEMBER 12, 1884.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1884.

No. 1242.

JOHN A. WOLLENSAK, APPELLANT,

vs.

FRANK A. REIHER.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF ILLINOIS.

INDEX.

	Original.	Print
Caption	1	1.
Bond for costs	1	1
Bill of complaint	2	1
Letters-patent No. 148,538 granted John F. Wollensak, March 10, 1874	10	5
Letters-patent, reissue No. 10264 granted John F. Wollensak, Dec. 26, 1882	13	7
Subpœna	16	10
Marshal's return	17	10
Appearance	18	11
Demurrer	19	11
Exceptions to bill	22	13
Order taking cause under advisement	24	14
Opinion	26	14
Decree	29	16
Order allowing appeal	29	16
Bond	30	16
Clerk's certificate	32	17

JUDD & DETWEILER, PRINTERS, WASHINGTON.

1 Pleas in the circuit court of the United States of America for the northern district of Illinois, held at the United States court-rooms, in the city of Chicago, in the district aforesaid, before the Hon. Walter Q. Gresham, judge of the United States circuit court for the seventh circuit, on Friday, the twenty-first day of November, in the adjourned October term of said court, in the year of our Lord one thousand eight hundred and eighty-four, and of our Independence the one hundred and ninth year.

WM. H. BRADLEY, *Clerk.*

JOHN F. WOLLENSAK
vs.
FRANK A. REIHER. } In Chancery.

NORTHERN DISTRICT OF ILLINOIS, *ss:*

Be it remembered that on the eighteenth day of September, A. D. 1884, came John F. Wollensak, the complainant, by his solicitors, and filed in the office of the clerk of the circuit court of the United States for the northern district of Illinois, at Chicago, in said district, his bond for costs and bill of complaint in said entitled cause, which said bond and bill are respectively in the words and figures following, to wit:

Bond.

UNITED STATES OF AMERICA,
Northern District of Illinois, } *ss:*

Circuit Court. Oct. Term, A. D. 1884.

2 JOHN F. WOLLENSAK *vs.* FRANK A. REIHER.

I enter myself security for costs in this cause, and promise to pay all costs which may accrue to the opposite party in this action, or to any of the officers of this court, and in default of payment by the complainant of any costs ordered or adjudged to be paid by him, hereby agree and stipulate that execution may issue against my property for any costs taxed against him. Dated this 18th day of September, A. D. 1884.

THOMAS A. BANNING.

Endorsed: Filed Sept. 18, A. D. 1884. Wm. H. Bradley, clerk.

Bill.

To the honorable the judges of the circuit court of the United States for the northern district of Illinois:

John F. Wollensak, of the city of Chicago, in the State of Illinois, complainant, brings this his bill against Frank A. Reiher, of the city of Chicago, in the State of Illinois, and a citizen of the State of Illinois, defendant, and thereupon your orator complains and says:

1. That prior to the 10th day of March, A. D. 1874, your orator was the original and first inventor and discoverer of a new and

useful improvement in transom lifters, not known or used
3 by others before his invention thereof, and which had not, at the time of his application for a patent therefor, been in public use or on sale for more than two years, and that upon application therefor letters patent of the United States No. 148,538 were issued to your orator, dated the said 10th day of March, 1874, granting to him, his heirs or assigns, for the term of seventeen years, the full and exclusive right of making, using, and vending to others to be used, the said invention, as by reference to said letters patent here in the court to be produced, and a copy of the specification and drawings of which is hereto attached, will more fully appear.

2. That said letters patent being afterwards found to be inoperative or invalid by reason of an insufficient or defective specification, which insufficiency or defect had arisen through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention on the part of your orator, were afterwards surrendered and duly canceled by the Commissioner of Patents; that thereupon, and upon due application therefor, reissued letters patent of the United States No. 10264 were issued to your orator, dated the 26th day of December, 1882, granting to him, his heirs or assigns, for the term of seventeen years from the said 10th day of March, 1874, the full and exclusive right of making, using, and vending to others to be used, the said invention, as by reference to said reissued letters patent here in court to be produced, and a copy of the speci-
4 fication and drawings of which is hereto attached, will more fully appear; that said reissued letters patent were applied for in good faith and not for any fraudulent or improper purpose; that, as your orator verily believes, no other person, firm, or corporation, not acting under his authority, ever began the manufacture, sale, or use of transom lifters containing or embodying said inventions or improvements until long after your orator had consulted counsel and taken steps toward applying for said reissue, and until long after your orator had applied for and obtained a reissue of his previous patent on transom lifters having broader claims than any now contained in said reissue No. 10264; that in making said application for said last-mentioned reissue your orator presented to the Patent Office a full, sworn statement of facts and circumstances connected with his applying for and obtaining said original patent No. 148,538, and with his delay in applying for said reissue; that at the first said reissue application was rejected, on the ground that such statement did not show or furnish any sufficient explanation or excuse for said delay, and that your orator had lost his rights to such a reissue by reason thereof, the examiner citing Miller *vs.* Brass Company (104 U. S., 350), and other cases; that on appeal said decisions or rejection was reversed by the examiners-in-chief constituting the Patent Office Board of Appeal; that in a long and full opinion said examiners-in-chief expressly held that
5 your orator had sufficiently and satisfactorily explained said delay and was still entitled to such a reissue, and that a part of said opinion, referring to claims appearing in said reissue, and now in controversy, was as follows:

"All the above claims, moreover, have been rejected upon a supposed legal bar to enlargement of claim found in certain recent decisions of the courts, mainly of the Supreme Court of the U. S., on which the other decisions cited are based. * * * We find upon review that there was a grave defect in applicant's patent and claims, whereby it was inoperative to protect the invention disclosed by him to the full extent to which he was entitled. * * * We do not find any evidence of such laches or delay, after ascertaining the defects of his patent, as to debar or estop him from the benefits of the statute. We do not find in his renewed application any attempt to enlarge the scope of his invention beyond what was originally disclosed, but, on the contrary, an attempt to secure protection for the invention contained in the patent."

3. That your orator verily believes that he was the first inventor and discoverer of said improvements and inventions described and claimed in said reissued letters patent, and that said reissued letters patent are good and valid in law; that, so far as he knows or has ever heard, the public generally acknowledge and acquiesce in the validity thereof; that the exclusive rights and privileges secured thereby are of great value; that your orator is, and long has been, en-
6 gaged in manufacturing and selling transom lifters containing said inventions and improvements, and has a large and established business therein, and that your orator is the sole and exclusive owner of said reissued letters patent, and of all claims for damages sustained by him, and for profits made or received by others from or by reason of infringements thereof, and is by law entitled to sue for and receive such claims to his own use.

4. That since the granting of said reissued letters patent, and at divers times and occasions between that time and the filing of this your orator's bill, Frank A. Reiher, the defendant herein, well knowing the premises, and in infringement of the third, fourth, fifth, sixth, and ninth claims of said reissued letters patent, and in violation of the exclusive rights of your orator thereunder, and without the license of your orator, at Chicago, to wit, at the district aforesaid, has made and sold to others for use, and still continues to make and sell to others for use, transom lifters containing and embodying the said inventions described in said reissued letters patent as aforesaid, and claimed in the third, fourth, fifth, sixth, and ninth claims thereof; that said defendant has been notified of his said infringement and requested to desist therefrom, but that he refuses so to do, and persists in making and selling said transom lifters in open and notorious disregard of said patent; that great and irreparable damages and injury has resulted to your orator from said infringement, and great gains and profits have accrued to said defendant there-
7 from, the full amount of which is unknown to your orator, but which in equity belongs to him, and should be accounted for by said defendant, and paid over to your orator as the avails of his exclusive rights aforesaid, and profits and gains which he would have derived therefrom but for the unlawful acts of the said defendant, and that your orator has reason to believe and fear, and does believe and fear, that he will continue to suffer great loss and dam-

useful improvement in transom lifters, not known or used
3 by others before his invention thereof, and which had not, at the time of his application for a patent therefor, been in public use or on sale for more than two years, and that upon application therefor letters patent of the United States No. 148,538 were issued to your orator, dated the said 10th day of March, 1874, granting to him, his heirs or assigns, for the term of seventeen years, the full and exclusive right of making, using, and vending to others to be used, the said invention, as by reference to said letters patent here in the court to be produced, and a copy of the specification and drawings of which is hereto attached, will more fully appear.

2. That said letters patent being afterwards found to be inoperative or invalid by reason of an insufficient or defective specification, which insufficiency or defect had arisen through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention on the part of your orator, were afterwards surrendered and duly canceled by the Commissioner of Patents; that thereupon, and upon due application therefor, reissued letters patent of the United States No. 10264 were issued to your orator, dated the 26th day of December, 1882, granting to him, his heirs or assigns, for the term of seventeen years from the said 10th day of March, 1874, the full and exclusive right of making, using, and vending to others to be used, the said invention, as by reference to said reissued letters patent here in court to be produced, and a copy of the speci-
4 fication and drawings of which is hereto attached, will more fully appear; that said reissued letters patent were applied for in good faith and not for any fraudulent or improper purpose; that, as your orator verily believes, no other person, firm, or corporation, not acting under his authority, ever began the manufacture, sale, or use of transom lifters containing or embodying said inventions or improvements until long after your orator had consulted counsel and taken steps toward applying for said reissue, and until long after your orator had applied for and obtained a reissue of his previous patent on transom lifters having broader claims than any now contained in said reissue No. 10264; that in making said application for said last-mentioned reissue your orator presented to the Patent Office a full, sworn statement of facts and circumstances connected with his applying for and obtaining said original patent No. 148,538, and with his delay in applying for said reissue; that at the first said reissue application was rejected, on the ground that such statement did not show or furnish any sufficient explanation or excuse for said delay, and that your orator had lost his rights to such a reissue by reason thereof, the examiner citing Miller *vs.* Brass Company (104 U. S., 350), and other cases; that on appeal said decisions or rejection was reversed by the examiners-in-chief constituting the Patent Office Board of Appeal; that in a long and full opinion said examiners-in-chief expressly held that
5 your orator had sufficiently and satisfactorily explained said delay and was still entitled to such a reissue, and that a part of said opinion, referring to claims appearing in said reissue, and now in controversy, was as follows:

"All the above claims, moreover, have been rejected upon a supposed legal bar to enlargement of claim found in certain recent decisions of the courts, mainly of the Supreme Court of the U. S., on which the other decisions cited are based. * * * We find upon review that there was a grave defect in applicant's patent and claims, whereby it was inoperative to protect the invention disclosed by him to the full extent to which he was entitled. * * * We do not find any evidence of such laches or delay, after ascertaining the defects of his patent, as to debar or estop him from the benefits of the statute. We do not find in his renewed application any attempt to enlarge the scope of his invention beyond what was originally disclosed, but, on the contrary, an attempt to secure protection for the invention contained in the patent."

3. That your orator verily believes that he was the first inventor and discoverer of said improvements and inventions described and claimed in said reissued letters patent, and that said reissued letters patent are good and valid in law; that, so far as he knows or has ever heard, the public generally acknowledge and acquiesce in the validity thereof; that the exclusive rights and privileges secured thereby are of great value; that your orator is, and long has been, en-
6 gaged in manufacturing and selling transom lifters containing said inventions and improvements, and has a large and established business therein, and that your orator is the sole and exclusive owner of said reissued letters patent, and of all claims for damages sustained by him, and for profits made or received by others from or by reason of infringements thereof, and is by law entitled to sue for and receive such claims to his own use.

4. That since the granting of said reissued letters patent, and at divers times and occasions between that time and the filing of this your orator's bill, Frank A. Reiher, the defendant herein, well knowing the premises, and in infringement of the third, fourth, fifth, sixth, and ninth claims of said reissued letters patent, and in violation of the exclusive rights of your orator thereunder, and without the license of your orator, at Chicago, to wit, at the district aforesaid, has made and sold to others for use, and still continues to make and sell to others for use, transom lifters containing and embodying the said inventions described in said reissued letters patent as aforesaid, and claimed in the third, fourth, fifth, sixth, and ninth claims thereof; that said defendant has been notified of his said infringement and requested to desist therefrom, but that he refuses so to do, and persists in making and selling said transom lifters in open and notorious disregard of said patent; that great and irreparable damages and injury has resulted to your orator from said infringement, and great gains and profits have accrued to said defendant there-
7 from, the full amount of which is unknown to your orator, but which in equity belongs to him, and should be accounted for by said defendant, and paid over to your orator as the avails of his exclusive rights aforesaid, and profits and gains which he would have derived therefrom but for the unlawful acts of the said defendant, and that your orator has reason to believe and fear, and does believe and fear, that he will continue to suffer great loss and dam-

age unless the said defendant be restrained from the further infringement of said reissued letters patent.

5. That your orator has no adequate remedy in the premises save in a court of equity, where matters of this nature are properly cognizable.

6. To the end, therefore, that the said defendant, Frank A. Reiher, may answer the premises, (but not under oath, an answer under oath being hereby expressly waived); that said defendant may be enjoined and restrained, as well preliminarily and provisionally as perpetually, from further infringing the third, fourth, fifth, sixth, and ninth claims of said reissued letters patent, and violating your orator's exclusive rights thereunder; that said defendant may be decreed to account with and pay over to your orator all the gains, profits, savings, and advantages to be duly determined, made, derived or received by him from the unlawful use of said patented invention as aforesaid, and all damages resulting to your orator therefrom, together with such increase over the actual dam-
8 ages suffered as is warranted by law and may seem just and proper; and that your orator may have such other and further relief in the premises as may be agreeable to equity and good conscience and as to your honors shall seem meet—

7. May it please your honors to grant unto your orator the writ of subpœna issued out of and under the seal of this honorable court, directed to the said defendant, Frank A. Reiher, commanding him, by a certain day and under a certain penalty, to be and appear in this honorable court, then and there to answer the premises and to stand to and abide by such order and decree as may be made against him, and also the writ of injunction, as well preliminary and provisional as perpetual, issuing out of and under the seal of this honorable court, enjoining and restraining the said defendant, Frank A. Reiher, his agents, attorneys, servants, and workmen, and each and every of them, as is heretofore in that behalf prayed.

And your orator will ever pray, etc.

JOHN F. WOLLENSAK.

BANNING & BANNING,
Solicitors for Complainant.
WEST & BOND,
Of Counsel.

STATE OF ILLINOIS, }
Cook County, } *ss:*

John F. Wollensak, the above-named compliant, being duly sworn, upon oath says: That he has read the foregoing bill subscribed by him and knows the contents thereof, and that the same is true of his own knowledge, except as to matters therein
9 stated on information and belief, and as to these he believes it to be true.

JOHN F. WOLLENSAK.

J. F. WOLLENSAK.

Transom-Lifters.

No. 148,538. Patented March 10. 1874.

Fig. 1.

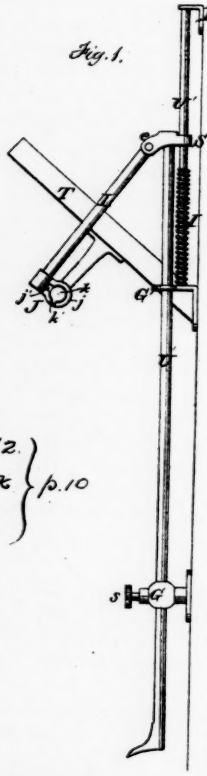


Fig. 2.

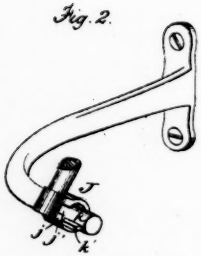


Fig. 3.

No. 1242.
Wollensak
"
Reiher.
} p. 10

Witnesses.
C. H. Burnett.
Matilda Schmeck

Inventor
J. F. Wollensak.
by his Attys.
Hill & Ellsworth

10 Subscribed and sworn to before me, this 15th day of September, A. D. 1884.

[SEAL.] CHARLES C. LINTHICUM,
Notary Public.

(Here follows diagram, marked page 10.)

11 UNITED STATES PATENT OFFICE.

JOHN F. WOLLENSAK, of Chicago, Illinois.

Improvement in Transom Lifters.

Specification forming part of letters patent No. 148,538, dated March 10, 1874; application filed February 14, 1874.

CASE B.

To all whom it may concern:

Be it known that I, John F. Wollensak, of Chicago, in the county of Cook and State of Illinois, have invented certain new and useful improvements in transom lifters; and I do hereby declare the following to be a full and exact description of the same, reference being had to the accompanying drawings forming part of this specification, in which—

Figure 1 is a side elevation, and Figs. 2 and 3 views of parts in detail.

Similar letters of reference in the accompanying drawings denote the same parts.

This invention is an improvement upon my patent dated March 11, 1873, No. 136,801, in which provision was made against the bending of the long upright rod or handle of the transom lifter by the weight of the sash at the point where it was jointed to the lifting arm connected to the side or edge of the sash, this being accomplished by prolonging the upright rod above the point of junction of the lifting arm, and providing said upright rod with a friction roller at the point of junction, said roller bearing against the wall and helping to sustain the weight of the sash.

The object of the present invention is to provide means for supporting the upright rod against the bending pressure of the sash, when the latter is hinged at its bottom, and at the same time prevent the breakage of glass in the transom in case the latter is allowed to fall suddenly. It also has for its object to provide improved means for connecting the lifting arm to the transom. To these ends, the invention consists, first, in jointing the lifting arm to its operating rod or handle at the upper end of the latter; and in providing the operating rod or handle with a socket at or near its junction with the lifting arm, said socket sliding on a stationary upright rod attached to the wall; secondly, in interposing a spiral spring on the stationary rod between the sliding socket and the upper guide bracket of the operating rod in such manner as to sustain the weight of the sash when it is lowered, and prevent any sharp concussion when the transom falls suddenly; and, finally, in

a bayonet joint connecting the lifting arm to the bracket on the transom, said joint being formed by a tongue on the end of the bracket and a corresponding slot in the socket on the arm, the parts being so arranged that they cannot be disconnected in any part of the arc described by the transom when the lifting arm is attached to the operating rod, all of which I now proceed to describe.

In the drawings, T is the transom sash, pivoted or hinged, in the present instance, at its lower edge; L, the lifting arm, that connects the sash to the upright rod; U, the upright rod, passing through two guides, G G′, both of which are located below the junction of the rods L U, the guides G being provided with a set screw, *s*, arranged to hold the rod U at any point desired. The upright U, instead of being prolonged at its upper end above its junction with the lifting arm, as in my former patent, terminates at that point, and is provided at the front with ears *e*, to which the lifting rod is pivoted, and at the rear with a socket, S, which incloses and slides upon a stationary upright rod, U′. The latter is supported at its lower end, below the socket S, by the bracket composing the guide G′ of the rod U, and at its upper end by a bracket, B. I represents a spiral spring, inclosing the rod U′ between the socket S and the guide G′.

It will be seen that the weight of the sash is supported equally by the rods U U′ and their brackets, and cannot bend either. When the sash is lowered until the socket S comes in contact with the upper end of the spring I, its weight is sustained by the latter vertically; consequently when the sash is allowed, through carelessness, to fall suddenly, the spring relieves the shock, which would otherwise occur, and prevents damage to the glass. The lifting arm L is attached to the bracket B of the transom sash by a bayonet joint, J, the end of the arm having a socket, *j*, with a slot, *j′*, and the bracket having a pin or bearing, *k*, with a tongue, *k′*, adapted to enter the socket and its slot when the tongue and slot are in line. The latter parts are so arranged, however, that they cannot come in line in any portion of the arc described by the bracket B in the operation of the transom, so that the arm and bracket cannot be disconnected while in working position.

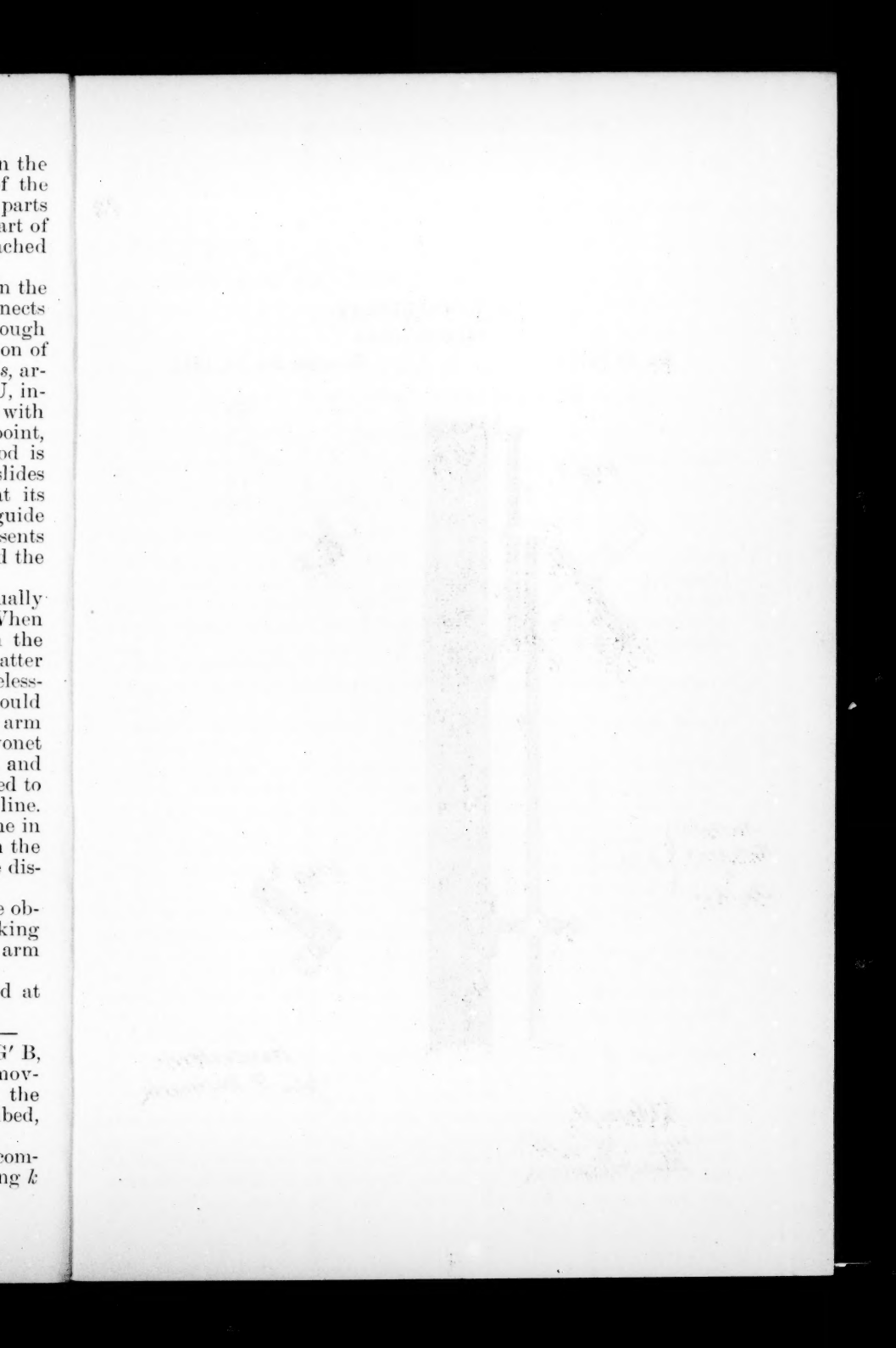
12 The advantages resulting from these improvements are obvious—the spring guarding against any liability of breaking the glass, and the joint facilitating the connection of the lifting arm to the bracket of the sash.

In heavy transoms, I propose to employ the devices described at each end of the sash, making it doubly secure against accident.

Having thus described my invention, what I claim as new is—

1. The stationary upright rod U′, supported by brackets G′ B, and provided with a spiral spring, I, in combination with the movable upright rod U, having the socket S arranged at or near the junction of the rod U and lifting arm L, substantially as described, for the purpose specified.

2. The lifting arm L, having the socket *j* and the slot *j′*, in combination with the transverse bracket B, having the pin or bearing *k*



J. F. WOLLENSAK.

TRANSOM LIFTER.

No. 10,264. Reissued Dec. 26, 1882.

Fig. 1.

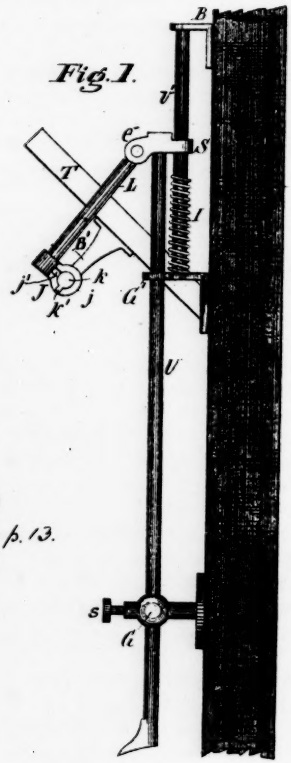
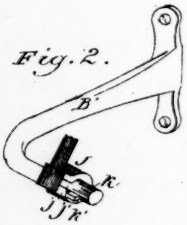


Fig. 2.



No. 12412.
Wollensak.
v.
Reiher.
} p. 13.

Fig. 3

Attest:
Hyam Smith
Thomas A. Banning

Inventor:
John. F. Wollensak

and tongue *k'*, arranged and operating substantially as and for the purpose specified.

13

JOHN F. WOLLENSAK.

Witnesses:
CHARLES ABEL, JR.
INGOLF K. BAYESEN.

(Here follows diagram, marked p. 13.)

14

UNITED STATES PATENT OFFICE.

JOHN F. WOLLENSAK, of Chicago, Illinois.

Transom Lifter.

Specification forming part of reissued letters patent No. 10264, dated December 26, 1882. Original No. 148,538, dated March 10, 1874. Application for reissue filed May 31, 1882.

To all whom it may concern:

Be it known that I, John F. Wollensak, of Chicago, in the county of Cook and State of Illinois, have invented certain new and useful improvements in transom lifters; and I do hereby declare the following to be a full and exact description of the same, reference being had to the accompanying drawings, forming part of this specification, in which—

Figure 1 is a side elevation, and Figs. 2 and 3 views of parts in detail.

Similar letters of reference in the accompanying drawings denote the same parts.

This invention is an improvement upon my patent dated March 11, 1873, No. 136,801, in which provision was made against the bending of the long upright rod or handle of the transom lifter by the weight of the sash at the point where it was jointed to the lifting arm connected to the side or edge of the sash, this being accomplished by prolonging the upright rod above the point of junction of the lifting arm and providing said upright rod with a friction roller at the point of junction, said roller bearing against the wall and helping to sustain the weight of the sash.

The object of the present invention is to provide means for supporting the upright rod against the bending pressure of the sash when the latter is hinged at its bottom, and at the same time prevent the breakage of glass in the transom in case the latter is allowed to fall suddenly.

It also has for its object to provide improved means for connecting the lifting arm to the transom.

To these ends the invention consist, first, in jointing the lifting arm to its operating rod or handle at the upper end of the latter, and in providing the operating rod or handle with a socket at or near its junction with the lifting arm, said socket sliding on a stationary upright rod attached to the wall; secondly, in interposing a spiral spring on the stationary rod between the sliding socket and the

upper guide bracket of the operating rod in such manner as to sustain the weight of the sash when it is lowered, and prevent any sharp concussion when the transom falls suddenly; and, finally, in a bayonet joint connecting the lifting arm to the bracket on the transom, said joint being formed by a tongue on the end of the bracket and a corresponding slot in the socket on the arm, the parts being so arranged that they cannot be disconnected in any part of the arc described by the transom when the lifting arm is attached to the operating rod, all of which I will now proceed to describe.

In the drawings, T is the transom sash, pivoted or hinged in the present instance at its lower edge; L, the lifting arm, that connects the sash to the upright rod; U, the upright rod, passing through two guides, G G′, both of which are located below the junction of the rods L U, the guide G being provided with a set screw, *s*, arranged to hold the rod U at any point desired. The upright rod U, instead of being prolonged at its upper end above its junction with the lifting arm, as in my former patent, terminates at that point, and is provided at the front with ears *e*, to which the lifting rod is pivoted, and at the rear with a socket, S, which incloses and slides upon a stationary upright rod or long guide, U′. The latter is supported at its lower end below the socket S by the bracket composing the guide G′ of the rod U and at its upper end by a bracket, B.

I represents a spiral spring, inclosing the rod U′ between the socket S and the guide G′.

B′ is a reversible bracket on the transom sash, adapted to be inserted from either side of the socket on the lifting arm L. It will be seen that the weight of the sash is supported equally by the rods U U′ and their brackets, and cannot bend either. When the sash is lowered until the socket S comes in contact with the upper end of the spring I its weight is sustained by the latter vertically. Consequently when the sash is allowed through carelessness to fall suddenly, the spring relieves the shock which would otherwise occur, and prevents damage to the glass. The lifting arm L is attached to the bracket B′ of the transom sash by a bayonet joint, J, the end of the arm having a socket, *j*, with a slot, *j′*, and the bracket having a pin or bearing, *k*, with a tongue, *k′*, adapted to enter the socket and its slot when the tongue and slot are in line. The latter parts are so arranged, however, that they cannot come in line in any portion of the arc described by the bracket B′ in the operation of the transom so that the arm and bracket cannot be disconnected while in working position.

The advantages resulting from these improvements are obvious, the spring guarding against any liability of breaking the glass, and the joint facilitating the connection of the lifting arm to the bracket of the sash.

In heavy transoms I propose to employ the devices described at each end of the sash, making it doubly secure against accident.

Having thus described my invention, what I claim as new is—

1. The stationary upright rod U′, supported by brackets G′, B, and provided with a spiral spring I, in combination with the mov-

able upright rod U, having the socket S, arranged at or near the junction of the rod U, and lifting arm L, substantially as described for the purpose specified.

2. The lifting arm L, having the socket *j* and slot *j'*, in combination with the transverse bracket B', having the pin or bearing *k* and tongue *k'*, arranged and operating substantially as and for the purpose specified.

3. The combination, with a transom window, of the bracket B', lifting arm L, long guide U', and lifting rod U, having sliding connection with guide rod U', all substantially as described, and for the purposes set forth.

4. The combination, with a transom window and its vertical lifting rod, of a long stationary guide and support for the upper end of the vertical lifting rod, by which the latter is held to a rectilineal path through suitable connections, substantially as described, and for the purposes set forth.

5. The combination, with a transom window, of the separate guide U', socket S, vertical lifting rod, substantially as described, and for the purposes set forth.

6. The combination, with a transom window, of the guide U', guide socket S, vertical lifting rod U, and connecting rod or arm L, and suitable transom connections, all substantially as described, and for the purposes set forth.

7. The combination, with the lifting rod and the means by which it is connected to the transom, of a spring to receive the shock of the window in falling or swinging suddenly, substantially as described, and for the purposes set forth.

8. The stationary upright rod or guide U', supported on the casing and provided with a spiral spring, I, in combination with the movable upright rod U, having the socket S, arranged at or near the junction of said rod with the lifting arm L, and suitable transom connections, all substantially as described, and for the purposes set forth.

9. The combination, with a transom lifting rod and lifting arm, of a reversible bracket, B', for connecting the transom with the lifting arm, substantially as described, and for the purposes set forth.

JOHN F. WOLLENSAK.

Witnesses:

CHARLES C. LINTHICUM.
THOMAS A. BANNING.

Endorsed: Filed Sept. 18, 1884. Wm. H. Bradley, clerk.

16 On the same day, to wit, on the eighteenth day of September, 1884, there issued out of said clerk's office a writ of subpœna in said entitled cause, which said writ, together with the return of the marshal thereto attached, are in the words and figures following, to wit:

Subpœna.

UNITED STATES OF AMERICA, } ss:
Northern District of Illinois, }

The United States of America to Frank A. Reiher, Greeting:

We command you that you appear before our judges of our circuit court of the United States of America for the northern district of Illinois, at Chicago, in said district, on the first Monday in the month of November next, to answer the bill of complaint of John F. Wollensak, this day filed in the clerk's office of said court, in said city of Chicago, then and there to receive and abide by such judgment and decree as shall then or thereafter be made, upon pain of judgment being pronounced against you by default.

To the marshal of the northern district of Illinois to execute.

Witness the Hon. Morrison R. Waite, Chief Justice of the Supreme Court of the United States of America, at Chicago aforesaid, this 18h day of September, in the year of our Lord one thousand eight 17 hundred and eighty-four, and of our Independence the 109th year.

[SEAL.] WM. H. BRADLEY, *Clerk.*

Memorandum.

The above-named defendant is notified that unless he shall enter his appearance in the clerk's office of said court, at Chicago aforesaid, on or before the day to which the above writ is returnable, the complainant's bill will be taken against him as confessed and a decree entered accordingly.

WM. H. BRADLEY, *Clerk.*

Special Deputy's Return.

UNITED STATES OF AMERICA, } ss:
Northern District of Illinois, }

Know all men by these presents, that I have appointed, and by these presents do appoint, Geo. N. Jones my true and lawful deputy to execute the annexed writ—John F. Wollensak *vs.* Frank A. Reiher—and to make return of the execution thereof according to law.

A. M. JONES, [SEAL.]
U. S. Marshal for the Northern District of Illinois.

I have served the annexed writ in the following manner, to wit: By delivering a true copy thereof to Frank A. Reiher, therein named, on the 18th day of September, A. D. 1884.

A. M. JONES,
United States Marshal,
By GEO. N. JONES,
Special Deputy.

UNITED STATES OF AMERICA, *Northern District of Illinois,* } ss:

18 Geo. N. Jones, being duly sworn, deposes and says: That he served the annexed writ, as stated in the foregoing return, and that the expense returned by him, in addition to the fees, was actually incurred, and that the same is according to law.

GEO. N. JONES.

Subscribed and sworn to before me, this 18th day of September, A. D. 1884.

[SEAL.] SAMUEL C. HAYES,
Notary Public.

Endorsed: Filed Sept. 19, A. D. 1884. Wm. H. Bradley, clerk.

Afterwards, to wit, on the twenty-third day of October, 1884, came the defendant, by his solicitor, and filed in said clerk's office his appearance in said entitled cause, which said appearance is in the words and figures following, to wit:

Appearance.

In the Circuit Court of the United States for the Northern District of Illinois.

JOHN F. WOLLENSAK
vs.
FRANK REIHER. } In Chancery. Gen. No. 19223.

I hereby enter my appearance in the above-entitled case, on behalf of the defendant herein.

Chicago, October 23, 1884.

CHARLES T. BROWN.

Endorsed: Filed Oct. 23, 1884. Wm. H. Bradley, clerk.

19 Afterwards, to wit, on the tenth day of November, 1884, came the defendant, by his solicitor, and filed in said clerk's office his demurrer to the bill of complaint in said entitled cause, which said demurrer is in the words and figures following, to wit:

Demurrer.

In the Circuit Court of the United States for the Northern District of Illinois.

JOHN F. WOLLENSAK
vs.
FRANK A. REIHER. } In Chancery.

The demurrer of Frank A. Reiher, defendant, to the bill of complaint of John F. Wollensak, complainant.

This defendant, by protestation, not confessing or acknowledging all or any of the matters and things in the said bill of complaint

contained to be true, in such manner and form as the same are therein and thereby set forth and alleged, demurs to said bill, and for cause of demurrer shows:

That the said bill of complaint fails to show a cause of action against said defendant.

That the complainant has not, in his said bill of complaint, made or stated such a case as entitles him, in a court of equity, to any discovery or relief from or against this defendant, touching the matters contained in the said bill, or any of such matters.

20 And for further cause of demurrer this defendant shows:

That the reissued patent referred to and described in the paragraph or clause of said bill numbered "2" is void, and was issued without warrant of law, as appears by inspection thereof, in that the original patent surrendered for said reissue was not so surrendered within a reasonable time after the issuing of the said original patent and within such time as complainant was bound to do the same.

That said reissued letters patent were issued without warrant of law, as appears by inspection thereof, and are void, in that the complainant was guilty of great laches in obtaining the same, and thereby suffered the right, if any he had, to secure by said or any reissue letters patent, protection or otherwise, to all, if any there were, inventions not set out and properly claimed in the original patent, and that such laches were utterly without reason and without cause, as appears by said bill of complaint herein.

That so much of said bill of complaint as is included in paragraph numbered "2," between the word "that," at the commencement of the 17th line thereof, and the words "No. 10264," in the 24th line thereof, both inclusive, constitutes no cause of action against the defendant herein, or in any manner affects the same.

That so much of said bill of complaint as is included in paragraph numbered "2," between the word "that," in the 24th line thereof, and the end of said paragraph, constitutes no cause

21 of action against the defendant herein, or in any manner affects the same.

Wherefore, and for divers other good causes of demurrer appearing in the said bill of complaint, this defendant demurs to the said bill, and to all the matters and things therein contained, and prays the judgment of this honorable court whether he shall be compelled to make any other or further answer to the said bill, and he prays to be dismissed with his reasonable costs in this behalf sustained.

FRANK A. REIHER.

CHARLES T. BROWN,
Solicitor for Defendant.

I certify that, in my opinion, the foregoing demurrer of Frank A. Reiher, defendant, to the bill of complaint of John F. Wollensak, complainant, is well founded in law and proper to be filed in the above cause.

CHARLES T. BROWN,
Solicitor for Defendant.

STATE OF ILLINOIS, } ss:
County of Cook, }

Frank A. Reiher, the defendant, on oath states that he has heard read the foregoing demurrer to the bill of complaint of John F. Wollensak in this suit, and that the same is not interposed for the purpose of delay in said suit or any proceedings therein.

FRANK A. REIHER.

Subscribed and sworn to before me, this 8th day of November, A. D. 1884.

[SEAL.] FLORA L. BROWN,
Notary Public.

22 In the Circuit Court of the United States for the Northern District of Illinois.

JOHN F. WOLLENSAK } In Chancery.
vs.
FRANK A. REIHER. }

Exceptions taken by Frank A. Reiher, defendant, to the bill of complaint of John F. Wollensak, complainant, filed against him.

First. For that the allegations contained in the paragraph numbered "2," between the words "that," in the 17th line, and "No. 10264," in the 24th line thereof, in the words following, to wit: "That, as your orator verily believes, no other person, firm, or corporation not acting under his authority ever began the manufacture, sale, or use of transom lifters containing or embodying said inventions or improvements until long after your orator had consulted counsel and taken steps towards applying for said reissue, and until long after your orator had applied for and obtained a reissue of his previous patent on transom lifters, having broader claims than any now contained in said reissue No. 10264," is impertinent and ought to be expunged.

Second. For that the allegations contained in the paragraph numbered "2," between the words "that in," in the 24th line thereof, and the end of said paragraph, in the words following, to wit: "That in making said application for said last-mentioned reissue your orator presented to the Patent Office a full, sworn statement

23 of facts and circumstances connected with his applying for and obtaining said original patent No. 148,538, and with his delay in applying for his said reissue; that at the first said reissue application was rejected, on the ground that such statement did not show or furnish any sufficient explanation or excuse for said delay, and that your orator had lost his rights to such a reissue by reason thereof, the examiner citing Miller *vs.* Brass Company (104 U. S., 350), and other cases; that on appeal said decisions or rejection was reversed by the examiners-in-chief, constituting the Patent Office Board of Appeal; that in a long and full opinion said examiners-in-chief expressly held that your orator had sufficiently and satisfactorily explained said delay and was still entitled to such a reissue,

and that a part of said opinion, referring to claims appearing in said reissue and now in controversy, was as follows: "All the above claims, moreover, have been rejected upon a supposed legal bar to enlargement of claim found in certain recent decisions of the courts, mainly the Supreme Court of the U. S., on which the other decisions cited are based. We find upon review that there was a grave defect in applicant's patent and claims, whereby it was inoperative to protect the invention disclosed by him to the full extent to which he was entitled. We do not find any evidence of such laches or delay after ascertaining the defects of his patent as to debar or estop
24 him from the benefits of the statute. We do not find in his renewed application any attempt to enlarge the scope of his invention beyond what was originally disclosed, but, on the contrary, any attempt to secure protection for the invention contained in the patent," is impertinent and ought to be expunged.

In all which particulars this defendant humbly insists that the complainant's bill of complaint is irrelevant, impertinent, and scandalous; wherefore, this defendant excepts thereto and prays that the impertinent and scandal- of the said bill of complaint excepted to as aforesaid may be expunged, with costs.

CHARLES T. BROWN,
Solicitor for Defendant.

Endorsed: Filed Nov. 10, 1884. Wm. H. Bradley, clerk.

Afterwards, to wit, on the twelfth day of November, in the adjourned October term of said court, 1884, in the record of the proceedings thereof in said entitled cause, before Hon. Walter Q. Gresham, circuit judge, is the following entry, to wit:

Order.

JOHN F. WOLLENSAK
vs.
FRANK A. REIHER. } In Chancery.

Now come the parties by their solicitors, and this cause comes on to be heard upon the demurrer to the complainant's bill; and after hearing the arguments of counsel, the court takes the same under advisement.

25 Afterwards, to wit, on the twenty-first day of November, 1884, there was filed in said clerk's office the opinion of Judge Gresham in said entitled cause, which said opinion is in the words and figures following, to wit:

Opinion.

26 Circuit Court of the United States, Northern District of Illinois.

JOHN F. WOLLENSAK
vs.
FRANK A. REIHER. } In Equity. Nov. 21, 1884

GRESHAM, J.:

The bill avers that on the 10th day of March, 1874, patent No.

148,538 issued to the complainant for a new and useful improvement in transom lifters; that afterwards, finding this patent to be inoperative and invalid by reason of a defective specification arising through inadvertence, accident, or mistake, without any fraudulent or deceptive intention on his part, the complainant surrendered it, and on Dec. 26, 1882, caused to be issued to him reissued patent No. 10264; that he applied for the reissued patent in good faith; that he believed no person, firm, or corporation not acting under his authority ever begun the manufacture, sale, or use of transom lifters embodying his invention or improvement until long after he had consulted counsel and had taken steps towards applying for his reissue; that in making the application for a reissue he presented to the Patent Office a full, sworn statement connected with his applying for and obtaining the original patent, and of his delay in applying for the reissue; that his application was rejected on the ground that he failed to make a sufficient explanation or excuse for the delay in making it, but that on appeal this decision was reversed by the examiners-in-chief on the ground that the complainant had satisfactorily explained such delay, and that he was entitled to a reissue with enlarged claim, his original patent and claims
27 being inoperative to fully protect his invention; that he was the first inventor of the improvement described in his reissued patent; that it is good in law, and, so far as he knows or believes, the public has generally acknowledged its validity; that it is of great value, and he has long been engaged in making and selling transom lifters embodying his invention; that the defendant, without right, has made use of and sold, and continues to make use of and sell, transom lifters embodying the invention described in the reissued patent, and claimed in the third, fourth, fifth, sixth, and ninth claims thereof.

Copies of both the original and reissued patents are made parts of the bill. With the exception of seven additional claims in the reissued patent it is in all respects substantially like the original.

The suit is brought to enjoin the defendant from infringing the third, fourth, fifth, sixth, and ninth additional claims in the reissue, and for damages. The defendant demurs to the bill for want of equity.

The reissue was applied for more than eight years after the original patent was granted. Does the bill sufficiently explain this long delay? It is contended by the complainant's counsel that a reissue may be applied for and granted at any time before the expiration of a patent, and even during the extended term, provided adverse rights have not intervened. This view certainly finds no support in Miller *vs.* Brass Co., 104 U. S., 350. When an inventor receives his patent it is his duty to examine it promptly, see that his invention is properly described, and that his claims are broad enough to embrace it in all its scope. If upon a mere reading of his patent it is obvious that he is entitled to a reissue with broader and more comprehensive claims, he must make his application speedily. Failure to
28 do this is a dedication to the public of so much of his inven-

tion as it is not covered by his claim. The rule of laches is strictly applied in such cases.

Speaking of delay in asking for a reissue to enlarge the scope of the patent, the court in Miller *vs.* Brass Co., *supra*, say:

"And when this is a matter apparent on the face of the instrument upon a mere comparison of the original patent with the reissue, it is competent for the court to decide whether the delay is unreasonable, and whether the reissue was therefore contrary to law and void."

The bill shows no excuse for the long delay in applying for the reissue. The complainant slept upon his rights, and I think the claims which the defendant is alleged to have infringed are void.

The demurrer is therefore sustained, and the bill is dismissed for want of equity.

Endorsed: Filed Nov. 21, 1884. Wm. H. Bradley, clerk.

29 On the same day, to wit, on the twenty-first day of November, in the adjourned October term of said court, 1884, in the record of the proceedings thereof in said entitled cause, before Hon. Walter Q. Gresham, circuit judge, is the following entry, to wit:

Decree.

JOHN F. WOLLENSAK
vs.
FRANK A. REIHER. } In Chancery.

The court, having considered the demurrer of the defendant to the bill of complaint herein, sustains the same, and thereupon it is ordered that said bill be dismissed for want of equity at the complainant's cost.

Afterwards, to wit, on the fifth day of December, in the adjourned October term of said court, 1884, in the record of the proceedings thereof in said entitled cause, before Hon. Walter Q. Gresham, circuit judge, is the following entry; to wit:

Order.

JOHN F. WOLLENSAK
vs.
FRANK A. REIHER. } In Chancery.

Now comes the complainant, by his solicitors, and prays an appeal to the Supreme Court of the United States from the de-
30 cree entered of record November twenty-first, 1884, in said above-entitled cause, which is allowed upon his giving bond in the sum of three hundred dollars, to be approved by the court.

On the same day, to wit, on the fifth day of December, 1884, there was filed in said clerk's office an appeal bond in said entitled cause, which said appeal bond is in the words and figures following, to wit:

Appeal Bond.

Circuit Court of the United States, Northern District of Illinois.

JOHN F. WOLLENSAK
vs.
FRANK A. REIHER. } In Equity.

Know all men by these presents, that we, John F. Wollensak and Ephraim Banning, both of Chicago, Illinois, are held and firmly bound unto Frank A. Reiher, of the same place, in the penal sum of three hundred dollars ($300.00), lawful money of the United States, for the payment of which, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, firmly by these presents.

The condition of the above obligation is such, that whereas, on the 21st day of November, A. D. 1884, a final decree was entered in the above-entitled cause dismissing the bill of complaint
31 therein and against said John F. Wollensak for costs, from which decree the said John F. Wollensak has taken an appeal to the Supreme Court of the United States:

Now, therefore, if the said John F. Wollensak shall duly prosecute his said appeal with effect, and shall pay all damages and costs that may be awarded against him in case the said decree shall be affirmed in said Supreme Court, then the above obligation to be void; otherwise to remain in full force and effect.

In witness whereof, we have hereunto set our hands and seals, this 4th day of December, 1884.

JOHN F. WOLLENSAK. [SEAL.]
EPHRAIM BANNING. [SEAL.]

In presence of—
PIERCE BUTLER.

Approved.
W. Q. GRESHAM.

Endorsed: Filed Dec. 5, 1884. Wm. H. Bradley, clerk.

32 NORTHERN DISTRICT OF ILLINOIS, *ss:*

I, William H. Bradley, clerk of the circuit court of the United States for said northern district of Illinois, do hereby certify the above and foregoing to be a true and correct transcript of the record of all the proceedings had in said court in the cause wherein John F. Wollensak is complainant and Frank A. Reiher is defendant, as the same appear from the files and records of said court now remaining in my custody and control.

In testimony whereof, I have hereunto set my hand and affixed the seal of said court, at my office, in Chicago, in said district, this ninth day of December, A. D. 1884.

[SEAL.] WM. H. BRADLEY, *Clerk.*

Endorsed on cover: N. Illinois C. C. U. S. No. 1242. John A. Wollensak, appellant, *vs.* Frank A. Reiher. Filed December 12, 1884.

3—1242

115-87+96

Supreme Court of the United States

OCTOBER TERM.

JOHN F. WOLLENSAK,
Appellant,

vs.

FRANK A. REIHER,
Appellee.

Nos. 249 and 1242.

BRIEF FOR APPELLANT.

L. L. BOND,
EPHRAIM BANNING,
THOMAS A. BANNING,
Counsel for Appellant.

CHICAGO:
EASTMAN & ADAMS, LEGAL PRINTERS, 155 WASHINGTON ST.
1885.

Supreme Court of the United States

OCTOBER TERM.

JOHN F. WOLLENSAK,
Appellant,

vs.

FRANK A. REIHER,
Appellee.

BRIEF FOR APPELLANT.

No. 249.

Suit in this case is brought for the infringement of the 1st and 3d claims of reissue patent No. 9,307, to John F. Wollensak, for an Improvement in Transom Lifters, dated July 20, 1880. The original patent was granted March 11, 1873.

Proofs were taken, and upon final hearing the bill was dismissed for want of equity, without the delivering or filing of any opinion; therefore the assignment of errors must of necessity be general, and the case presented upon such issues of the pleadings as are supported by the proofs, and upon the contentions below, which were, as we understand them:

1. That under the limitations of the patent and of the prior art, the patent itself does not disclose a patentable improvement in respect to the claims complained of.

2. That the defendant did not infringe.

The error assigned is as follows, to wit:

That the court erred in dismissing the bill for want of equity.

The patent sued on was reissued more than two years after its issue, but the record does not show any issue upon the reissuing of the patent, or any exception made to the patent for this reason. The failure to make any point on this doubtless arose from the fact that the third claim, which is one of the claims relied on, is copied from the original, while the first claim—the other one relied on—is in strict accordance with the statement of invention made in the original patent; or it may have arisen from appellee's personal knowledge of appellant's meritorious position.

The first claim is new. The second and third are the first and second of the original patent.

Defendant attempts to justify in part under his own patent, dated April 6, 1880, but, from an examination of the record (p. 129), it will be seen that appellant filed his application for a reissue more than two years prior to the filing of the application upon which the patent was issued to defendant, so that no question of intervening rights can be raised herein.

The claims sued on are as follows:

"1. The combination, with the transom, its lifting-arm and operating-rod, of a guide for the upper end of the operating-rod, to prevent it from being displaced by the weight of the transom."

"3. The guide G', arranged above the ~~tension~~ junction of the lifting-arm and upright rod, in combination with the prolonged rod U, the guide C, and arm A, substantially as and for the purpose specified."

These claims are so near alike that they may be treated as one, or the case may be treated as resting upon the third claim, and when so treated, no questions of reissue law will be involved in the consideration of the case, as there is no

statement in the specification which gives the third claim of the reissue patent any more general, or broad construction, than would be given to it under the original specification. In fact, the description of the devices is not changed, and the clause which was injected into the reissue specification "to assist the law" is neither helpful nor harmful, as it in no way affects the scope of the patent, or the construction to be placed upon the claim.

The third claim is for a combination consisting of two supporting guides, one above and one below the pressure of the lifting arm point on the rod; the pivoted lifting-arm or link; the upright sliding or handle-rod, sufficiently prolonged to be supported on both sides of the junction of the pivoted arm.

As stated in the specification, the sliding rod with a pivoted arm connected to the end of the rod and with the transom sash, was old. The admission in the patent contains a nearer approach to the patented device than anything brought into the case by the proofs, the proofs showing that in practice the prior art consisted of cords and pulleys; a hinged stick like that used in supporting a piano cover, and a loose stick or boot-jack, constituted the entire prior art, as practiced.

The patent would stand upon a broader foundation if only the prior art proven was shown in the case, and as the art admitted by the patent is nearer than anything shown outside of it, the first question or point will stand or fall upon the *prima facie* construction of the patent itself.

I.

Does appellant's patent disclose a patentable invention? The differences between the prior device, admitted in the specification, and the combination of devices claimed, consists in this: In the old device the lifting link was pivoted to the end of the rod and to the transom sash. The rod was

vertically movable, and if any guides were used, they were of necessity below the lowest point of movement reached by lifting link, and there must therefore be the distance between the lowest and the highest limits of the movement of the arm and unsupported rod, or section of rod.

The difficulties in the way of this device were, that as the rod moved up it tended to vibrate or sway from side to side, to mar the casings, or to become permanently bent so as to be inoperative, and these difficulties practically prohibited the use of this rod; and the use of a strong, large, and unsightly bar would not prevent the marring of the casing, while the bending could be prevented in this manner; but it is insisted that, in this form, it falls short of the device of appellant's patent in the two respects in which the improvement is claimed.

This old rod did not and could not have an upper guide. The prolongation of the handle-rod involved the necessity of a separate device of some kind for attaching the lifting arm. A separate device for attaching the lifting-arm to the vertically moving or handle-rod involved the necessity of setting the rod out from the casing, or grooving the casing, and, in order to make the device an article of commerce, the cutting of the casing would not be a proper remedy, as then each lifter would require a separate fitting. The rod was therefore set out, as shown in the patents.

The rod, in order to be cheap, sightly and merchantable, must of necessity be small, and, being set out by the guides, it would be again liable to bend, and in order to avoid this, the coupling, or bracket, by which the lifting arm is attached to the rod, is made to extend back to reach the casing, and in the form shown it is provided with an anti-friction roller, which renders its movements easy and avoids scratching, but a sliding bracket having its corners rounded off (such as is shown in defendant's device) is the full equivalent of this roller bracket.

This bracket is not made an element of the third claim, but it is to be considered in arriving at the construction and operation of the patented device, and it is also one of the points of departure from the art, as admitted in the specification.

The next point of departure from the original type is in connecting the handle rod with a guide above its junction with the lifting arm. In the complainant's device this is done, first, by the use of the bracket just mentioned, which enables the lifting arm to be attached at any suitable point along the length of the rod, and, secondly, leaving a sufficient portion of the rod above the junction bracket to be supported in a guide or guide-way. This addition to the prior art is an important one for several reasons, as it enables the lifting arm to be supported upon and operated by a light handle rod; it prevents any of the parts from getting out of place; it permits of an easy and certain movement, and gives the device a steadiness in operation which it otherwise could not have.

As before stated, the new upper guide holds the rod out of contact with the casing of the transom, and it is not, therefore, a mere guide, but it is a *support*, operating as a guide when the band rod is moved, and operating as a permanent support for the rod when it is at rest, and in keeping it away from the casing to prevent marring or scratching, or metallic discoloration by the upper end of the rod. It is, therefore, a support in two senses—first, in respect to keeping the rod away from the casement, and, second, a support to keep it from bending in any direction, and, third, it is a guide for the movements of the rod.

From this we see that two important additions are made to the old device, and that these additions were essential appears not only from an inspection of the device, but it also appears from the fact that an improved device has gone into extensive use and has displaced everything known to

the art prior to the date of its introduction. It supplied a want which was felt; it supplied a place which the older devices were not sufficient to fill.

By any test which may be applied, it will be found that the device is materially improved by the inventions of the appellant; that his improvements make *the difference between failure and success*; between an article to be sought after, and an article to be avoided, if possible.

The combination of this third claim is not met in the prior art. The parts all co-act to produce, possibly not a new final result, but an old result in a new and practical manner. The parts put in combination all co-act to produce this result, and in this respect it is a legitimate combination, and the combination is new.

It seems clear, when the patent is properly considered in relation to its own admissions as to the prior art, and the prior art as shown, that the court erred in holding that the patent did not disclose or cover a patentable invention.

II.

It may be possible, and, in fact, probable, that the court below, in dismissing the bill, did not even consider the question of infringement. In stating the points, we have named it as one, for the reason that, if the patent is found to be valid, the question of infringement will require consideration.

As a general proposition, the only difference between the devices of the appellant and the appellee, so far as appellant's patent is concerned, is *the difference between prolonging the handle rod, and prolonging the upper guide.* The point of supporting the handle rod above the bracket of the lifting arm was worked out by the appellant. This problem being solved, it would occur to any good mechanic that there might be several ways of doing it, and the first and

most obvious way of doing it by a modification would be to prolong the guide and slot it, so that the bracket by which the lifting arm is attached to the rod could pass along the slot of the guide. This would be necessary, and would be understood by any mechanic, if the given problem was to move the bracket within the guide.

The question of infringement, so far as the third claim is concerned, appears to be whether a transom lifter, having an end of its lifting handle prolonged to work within a guide, and a transom lifter having a guide prolonged, so that the end of the lifting handle would remain within the guide, are substantially the same. That these two devices are well known equivalents; see Bates, p. 47, complainant's witness, and, of defendant's witnesses:—

Burkhart, p. 113.
Whittingham, p. 120.
Dayton, p. 126.

This agreement between the witnesses of both parties would seem to settle the question of infringement, as up to this state of the art appellee makes no claim for any invention or improvement in his own patent. The locking device, which it is proper to consider, will not be found an element of the third claim, but, even in the locking device, there is more similarity than would appear from a casual inspection.

The bracket through which the lifting arm is attached to the rod, and by which the rod connection is made, are almost identical in both devices. Wollensak's lifter is provided with an anti-friction roller; Rieher's is provided with a runner, or slide, having its ends rounded.

Lengthening the axis pin of the Wollensak roller gives the Reiher locking pin, and with a link connection of the lifting arm, the Wollensak rod is as easily rocked as the Reiher, so that all that Reiher has in fact added, is the locking notches, and the spring *f*, to keep the pin in en-

gagement with a locking notch. Appellant uses notches and set screws. Each device, whenever a movement is desired, requires unlocking and relocking, so that between the two there is no substantial difference in operation.

Whatever differences there may be between the two are mere *matters of addition* upon the part of appellee, and not matters of substitution or variation of the parts put in combination by the third claim of the appellant's patent.

The law is well settled that matters of addition do not avoid infringement.

"If the change introduced by the defendant constitutes a mechanical equivalent, in reference to the means used by the patentee, and, besides being such an equivalent, it accomplishes some other advantage beyond the effect or purpose accomplished by the patentee, *it will still be an infringement, as respects what is covered by the patent, although the further advantage may be a patentable subject, as an improvement upon the former invention.*"

Curtis on Patents, §311, p. 409.

Witnesses for appellee undertake to make some distinction, by giving the same parts in the Reiher device different names from those given in the Wollensak patent. Names have no controlling effect, as different devices may have the same name, and the same devices may have different names.

Bates v. *Coe*, 98 U. S., p. 42.

Appellee's expert is of the opinion that his device has no vertical supporting rod. It has the same rod that appellant's device has, and its handle rod supports the weight of the transom in the same way; that is, in both the bracket by which the lifting arm is connected with the handle rod has an immediate back support from the wall or frame of the door and transom.

Appellee's expert is also of the opinion that that portion of appellee's rod which is below the link-connecting

bracket is merely a handle. The downward extension is merely a handle in both devices. If it was desired to use a chair, stool or step ladder to operate them Wollensak's lifter could be made as short as Reiher's could, but neither one is made short and they both have the same length. That both may have the same length is self evident from the fact that when they are attached to the transom in the same relation to its hinge or pivot, they must have exactly the same movement, and no greater length can possibly be required for one than for the other.

Reiher connects his locking device with the upper bracket; Wollensak, with the lower, but it most certainly would not change the character of the Wollensak device to move the lower guide up to the lifting arm bracket, or to apply his set screw to the upper guide, but both Wollensak and Reiher *are extended down* to be within convenient reach to operate the transom from the floor, and the length of the extension, for this purpose, is the same in both and are handles or rods to the same extent and for the same purpose. This attempted distinction is therefore untenable. The rods are of the same length, and in both they are handle rods.

Another distinction attempted to be made, is, that in Wollensak, the rod supports the weight, while in Reiher, it is supported by the bracket resting upon the guide. This is untenable as a distinction, for if a strip of brass was extended from the Wollensak guide down to the lowest movement of its lifting arm bracket, they would be alike in this respect, so that this difference is simply the difference as to whether or not a strip of metal is interposed between the lifting arm bracket and the transom casing or not. This difference certainly cannot be a material one, and it certainly cannot be a difference by which the two devices in construction and operation can be differentiated.

There is no practical difference between the two and, as be-

fore stated, the only difference in their operation is the difference between locking the transom in position by locking the handle rod into a side notch, or locking it with a set screw. This, if it is a difference, is a mere matter of addition, as both are provided with locking devices working in notches. In one, the notches are in the guide; in the other, they are in the rod.

From this review of the case, the Reiher device appears clearly to be an infringement.

We have not thought it necessary to cite any of the numerous authorities in relation to what will and what will not support a patent for an improvement. This question must largely depend upon the facts in each case, taken with the general proposition of law that any departure from the original which produces a new and useful result, is sufficient to sustain the patent.

The improvements of Wollensak, as heretofore shown, produced several important and novel results, and we do not understand it to be necessary, in order to sustain a patent, that the invention should produce a new art or article, but in this case the proofs amply show that these improvements have produced substantially a new art, and an entirely new article in its line. This fact fully appears from the evidence of the leading architects, builders, and hardware dealers, who have tave testified in this cause.

In *Atlantic Works* v. *Brady*, 107 U. S., 192, and in several subsequent decisions, the court stated that the policy of the patent law was to reward such inventors as had made some material improvement or some advance in the art to which their improvements related. Applying this rule to the Wollensak improvements, we find that he has made a substantial improvement in the art; that he has made a new branch of trade; that his improvements have made a new article of manufacture, and that thereby the public, the manufac-

turers, and manufacturing interests of the country have received a material addition from his inventions and labors.

The policy of the English law is to reward any person who has added *to the trade* of the country by introducing therein a new or improved manufacture, either by invention or by importation. The ultimate object of the patent law in both countries is to improve the condition of the people by improving its mechanic arts, machinery, and appliances, by adding thereto new or improved features, or by producing devices which will add to the convenience in, or better use of, things already known.

Hinged and pivoted transoms were known prior to the date of Wollensak's invention, but, owing to the lack of facilities or suitable devices for operating them, they were usually left closed, and allowed, by the settling of the building or otherwise, to become fast in their casings, so as to be inoperative, and their use was almost restricted to lighting. The improvement of Wollensak has changed them so as to make them convenient for use as ventilators, and in fact, it may be said that his improvement has added the ventilator use to the ordinary transom.

Bayley & McCluskey's Patent.

We refer to this patent here, lest the court might infer that it had been overlooked, but we have not thought it necessary to refer to it for several reasons: First, because Wollensak, by his proofs, ante-dates it; second, because it does not contain the invention; and, third, for the reason before stated, that it does not come as near the invention as does the state of the art admitted in the appellant's specification.

It appears clearly from the record that Wollensak had his invention completed in 1866 in an operative form. On p. 68 he gives the history of the invention, and on p. 71 he states why he did not apply for a patent at an earlier date.

The date of invention is sufficient to relate the appellent's patent back to 1866.

"The date is important; for, by the rules of law, when a dispute arises as to the priority of *an invention*, a patentee is *allowed to show the real date* of it, and *have his rights as fully secured as if he had taken out his patent*, unless, indeed, he delayed his application in a manner and with views which are not imputed here. The date, therefore, with which we are to compare the testimony, in settling the claim of priority in invention, is, for this case, September, 1828, which was the date of the invention."

Parker v. *Hulme*, 1 Fish., 52.

"But when a patent is granted, *the right in the subject matter relates back to the time of the invention.*"

Curtis on Patents, §342, p. 467, 4th Ed.

"The publication to void the patent, must be anterior to *the discovrey* of the patentee. It is not sufficient that it should be anterior to the application to the Commissioner for a patent."

Bartholemew v. *Sawyer*, 1 Fish., 520.

See also: *Bates* v. *Coe*, 98 U. S., pp. 34 and 46.

If it should be considered that the delay between 1866 and 1873 was such a delay on the part of Wollensak, in applying for his patent, that whatever rights Bayley & McCluskey had were so far intervening that the court would not permit the Wollensak proofs to antedate it, it will still be seen from the File Record that it was cited, and the original and reissued patents granted, notwithstanding its existence. This Bayley & McCluskey device is for opening the entire series of small windows in the deck of a railway car or a steamboat, by one movement of a single lever, one-half opening in one direction and the other half in the opposite direction, the pivoted lever extending down into the body of the car or boat; and the only suggested modifica-

tion is, that a rock shaft may be run across to the opposite side, so that both sides of the car or boat may be operated in the same way by a single lever. When this lever is dispensed with, the devices are wholly inoperative, by reason of their want of connection, by being out of reach, and without means for taking hold of them. When the lever is taken off, the device bears about the same relation to the Wollensak device that the ordinary revolving slat window blind does, where the slats are connected, to a moving bar. This kind of a window blind contains the suggestion of the Wollensak improvements as nearly as the Bayley & McCluskey patent does.

The Board of Examiners-in-Chief, referring to the Bayley & McCluskey and Wollensak patents, say: "The one invention could never suggest or dominate the other, and if made by the same applicant the Office would undoubtedly be swift to require a division and separate patents for the same."

Bates, p. 56, clearly and fully explains the differences between the Wollensak and Bayley & McCluskey patents.

A device constructed in accordance with the state of the art, as set forth in the Wollensak specification, has been put in evidence as "Exhibit A." Appellant's witnesses all agree that it is practically a worthless device, and the appellee's witness, Whittingham, p. 120, was asked and answered as follows: "Q. In the case of a heavy transom, in your opinion, would the device marked A in the defendant's exhibit be a practical device? A. I do not think it would." There is no substantial disagreement among the witnesses; they all substantially agree that all of the devices in use prior to the Wollensak were impracticable and worthless.

This disposes of all the questions which can be raised in the case No. 249, as before stated, with the exception of the possible question of delay in reissuing, which is not raised

or put in issue in this case, but which is raised in case No. 1,242, where the reissue question is the sole question to be considered; and, as before stated, it is not necessary to consider it in this case, for the reason that the subject matter of the third claim is substantially the same as the first or the new claim, and the third, being repeated from the original patent, is not subject to the objection of being for new matter, and not liable to the objection of laches or delay in asserting it.

Gage v. *Herring*, 107 U. S., 640.

No. 1,242.

This appeal has been advanced to be heard with No. 249, for the reason that the parties are the same and the general subject matter the same, while the patent is a later one.

This cause came on to be heard on demurrer to the bill filed, and in this case the bill, although filed before the recent decision of *Mahn* v. *Harwood*, 112 U. S., 354, contained in it a statement that the facts and the reasons why the patent was not reissued at an earlier date had been furnished to and considered by the Commissioner of Patents. The defendant demurred, and upon the hearing of the demurrer the court held that the statement was not sufficient to excuse the delay; second, that more than two years having intervened between the issue and reissue, the patent, in so far as the new claims are concerned, was void.

In this case the court delivered an opinion, which is made a part of the record, pp. 14, 15, 16.

STATEMENT.

The bill was filed, and exceptions and demurrer were filed instead of an answer. The cause came on for hearing on the demurrer, which was sustained, and the bill dismissed. The patent sued on is Reissue No. 10,264, dated Dec. 26, 1882 (application filed May 31, 1882), it being a reissue of original patent No. 148,538, to J. F. Wollensak, March 10, 1874, for an Improvement in Transom Lifters.

The first and second claims of the reissue patent are the two claims of the original patent. The following seven claims are new, and infringement was claimed in respect to the third, fourth, fifth, sixth and ninth claims.

The second clause of the bill of complaint set forth as a fact, that there were no intervening rights between the issue

and the reissue; that a recital of the causes of, or reasons for, delay had been furnished to the Commissioner of Patents, and had by him been found to be sufficient, and that the said Commissioner had also found that, without the proposed amendments, the patent was inoperative to protect the patentee's invention, and that the reissue did not improperly attempt to enlarge the scope of the invention.

The bill does not, in terms, set up or repeat the reasons for the delay, but it shows that reasons existed which were satisfactory to the commissioner, and these reasons, under the allegations of the bill, or even without allegation of any kind, could properly be shown by proofs. The fact that there were reasons for the delay which the Commissioner of Patents found to be satisfactory, should of itself have been sufficient to prevent the dismissal of the bill by the court on a demurrer. The exceptions to the findings are:

1. That the court erred in holding that no valid excuse could be made for a delay extending over or beyond two years.

2. That the court, in the absence of proofs, erred in holding that the specific decision of the Commissioner of Patents on the patent in suit, upon the facts proven before him, that the delay in this particular case had not been unreasonable, was immaterial.

3. That the court erred in passing upon the question of the sufficiency of the excuses for the delay, on a demurrer to the bill.

The question is largely one of law; the law questions are, therefore, first presented, and we desire to say that we agree with the court in its opinion that the right to reissue has been greatly abused from the fact that, as a general practice, reissuing had become a fine art, and the ingenuity of parties had been put to its utmost capacity in generalizing inventions, away from devices, into functions and operations, and that, by reason of this, many hardships came to be perpe-

trated through the law, and that our sympathy is with the court in its endeavor to stop this species of injustice; but in doing this, we do not forget that there are many cases of reissue to which this fine art has not been applied, and where an honest inventor has only been endeavoring to get the control of that which, in fact, belonged to him.

In order to prevent injustice in one direction, we must not forget that, like vaulting ambition, we may overleap our object and land upon the other side, and we quote the following from the Popular Science Monthly, May, 1880, p. 75, from an article entitled the "Martyrdom of Science," reprinted from the London Journal of Sciences:—"In Britain an anti-scientific spirit still lingers more decidedly than elsewhere. * * * The manner in which inventors have often been treated in different parts of England seem to show that such feelings are widely spread. The country which first wins over her working classes to favor inventions and to become themselves inventors, will command the industrial supremacy of the world. America is fast attaining this object by her patent system, which enables even a poor man to secure his property in an invention. Our statesman, whig and tory alike, can scarcely be restrained from laying additional difficulties in the way of patent right."

A true inventor is always on the border land; he is dealing with the unknown, as attached to, or connected with, the known. That he should know all of the "knowable" cannot be expected. If he knows well what has come under his own observation he is an intelligent man, but it may well be that he is not able to describe the boundaries of his invention accurately, or to know the extent or value of that which he has particularly found out. He is not always fortunate in his employment of those who are supposed to be skilled in that direction, and from the fact that the Patent Office never suggests to any applicant that his invention is broader than his claims, he is always liable to take his pat-

ent for less than that which belongs to him, in cases where there is any considerable advance made by his invention or improvements.

Appreciating this fact, the law recognized the right of an inventor to have his patent corrected to make it co-extensive with his true invention, before there was any statute in existence regulating the reissuing of patents.

A brief historical review may be of value in this branch of the law.

The origin of patents is unknown, but they are of very ancient origin, and a patent case was decided in England as early as the reign of Edward III. (Hindmarch on Patents, 4.)

Up to the 21st of James I. patents were granted for inventions and for various monopolies, and were the same in form and in their recitations. At this date, patents for monopolies, such as the exclusive right to deal in wool, hides, various kinds of cloth, etc., were prohibited by Parliament. This statute, known as "The Statute of Monopolies," granted nothing. It simply cut off the monopoly patents, leaving new inventions and new manufactures, as stated by Lord Coke, "neither better nor worse than they were before."

These old patents contain nothing but the subject-matter title, and a recitation of warnings and penalties for infringement.

Occasionally a clause was inserted in the patent itself, requiring a specification of what was claimed under the title of the patent, to be filed within a certain time, therein stated, but prior to the reign of Queen Anne (1702) specifications were unknown. Afterwards, the requirement of a description by a patent grant became common, but in all of these early patents the specification was a mere description without claim or summary. The much litigated Neilson hot blast patent had no claim. The court was left to discover from the description what the invention really was, and in

all of these patents the invention was to be discovered from the instrument taken as a whole.

The correcting of a patent was a common law right, or, in other words, when a party had a patent, he had an inherent right to have it accurate.

Hindmarch, p. 211, says; "The Statute of William IV c. 83, left unchanged the common law power of altering and amending the entries and proceedings relating to patent grants and there are several alterations and amendments which can only be made by the common law." P. 214 he explains what these amendments are.

It being understood that the old patents, like the simple grant of an American patent, contained only the title or subject matter of the invention, it will appear that at the common law, even the title or subject matter of the patent might be altered or changed according to the truth or right of the invention, so that if the patent was granted for a plow, and the invention intended to be covered was for a harrow, the change could be made as a matter of right, and the fact that the patent was and is still issued in Great Britain before the specification is filed, is the cause or foundation for the English decisions relating to discrepancies between the title and the specification. After specifications were introduced they were matters subsequent to the grant and were limitations thereof.

The first legislation on the subject of reissues in this country, is Sec. 3, of the Act of July 3, 1832, and this legislation arose from the fact that this court, in *Grant* v. *Raymond*, 6 Peters, 218, had affirmed the right to surrender and reissue a patent, independent of any statute or legislation on that subject, holding that it was a common law right, and the duty of the Government to make a patent co-extensive with the actual invention.

It appears from Mr. Webster's brief in this case (which was not disputed), that the matter which the defendant was

found to infringe, was wholly new in the reissued patent; that there was not one word in the specification or line in the drawing which even remotely showed or hinted at any such invention as was inserted by the reissue amendment. Mr. Webster called the attention of the court to this open door for fraud, and to the danger of leaving additional inventions to be proved before an executive officer without contest, in cases where there was no foundation for the amendment in the original patent.

Under the old English patents, the patentee went into court and proved what invention his patent covered, by the production of a machine, and witnesses. The defendant was at liberty to contest the patent, by showing that the machine, or certain parts of it, was old, and thereby either defeated the patent or limited its scope, but under the system of reissuing, sustained in *Grant* v. *Raymond*, the party could claim what he pleased without any person being at liberty to contest or to controvert it, and it was therefore much more dangerous than the old English system of issuing patents without any specification at all.

Mr. Webster soon after the decision in *Grant* v. *Raymond*, as senator, procured the passage of the Act of July 3, 1832, limiting the right of reissue to such machine, or parts of the machine or device, as were somewhere shown in the specification, drawing or model of the original application, and thereby cut off the right of the patentee which had theretofore been recognized, to come in and prove orally, or otherwise, that he actually had the invention now sought to be inserted into the patent at the time it was originally granted. The prevention of the insertion of things not mentioned or shown was the object and purpose of the first Act relating to this subject.

Sec. 3, of the Act of July 3, 1832, became Sec. 13, of the Act of July 4, 1836, under which the Patent Office was established and the patent laws were revised. This section

was amended in 1837, by allowing divisions of reissue, and as amended it became Sec. 53 of the Act of July, 1870, and Sec. 4916 of the Revised Statutes of 1874, and these latter sections are substatially copied from the Act of July 4, 1836.

If we consider the changes in phraseology between the Act of 1836, as amended in 1837, and the Revised Statutes of 1874, we will find that Sec. 4916 of the Revised Statutes is even more liberal in relation to reissues than was the older Act, as it restored the common law right in cases where there was neither model nor drawing, and in authorizing the Commissioner of Patents to examine the application the same as an original one. The Statute declares that the reissue patent, after such an examination and allowance, " Shall have the same effect and operation in the law * * as if the same had been *originally filed* in such corrected form."

In the Act of 1836 the word " specification" was used in its military or first sense; that is, the word "specification" there means the pointing out of the particular item which is claimed to be of the patentee's invention, and does not refer to the description, the words "description and specification" being used in the Act, and are frequently so used in the old decisions, so that, by the Act of 1836, both the description and claims in terms could be altered or amended by reason of any accident, inadvertence, or mistake, while, by the Revised Statutes, the same change of the description and claims are both permitted; while there is no limitation of any kind upon the making of new claims. The word ' specification" in the Revised Statutes is used in its secondary or contract sense, or as used by architects for descriptions regulating the details of structures to be erected. The word "specification" is now used entirely in this sense, and the word " claim", is used in the sense in which the word " specification" was used in the older Acts.

Section 4916 only prohibits the introduction of new matter "into the specification," leaving, by necessary implication, the reissue applicant at liberty to make altered or new claims. There is no prohibition against inserting new matter in the way of claims, and as the statute now stands the description of the structure and operation of the machine cannot be changed by any new matter, but the claims based on the original structure may be.

The early rules of the re-organized Patent Office show that the Commissioner of Patents evidently understood that the reissue sections of the Acts of 1832 and 1836, only cut off the addition of such improvements as were outside of the original showing. In Golding's case Chief Justice Taney (then Attorney General) was of the opinion that an an assignee could not reissue his patent, because there "is no oath from the original patentee fortifying the *amended* specification and *testifying that the additions and alterations* now proposed to be made were *omitted*, by mistake, in the former patent." 2 Attorney General's Opinions, 575.

In this opinion the cases of *Grant* v. *Raymond*, and *Shaw* v. *Cooper*, 7 Pet., 29, decided after the passage of the Act of 1832, were both referred to. In the same volume 2, Opinions, 455, the same Attorney General says: "As the patent is granted for the benefit of the party, I perceive no reason why he should not be permitted to surrender it, and take a new one, *including an additional improvement, and having the same date* with original patent."

It is not necessary to follow the current of decsions to show that the Patent Office and the courts both understood that the patentee had an inherent right to have his patent co-extensive with his invention, and that claiming too little, as well as claiming too much, were equally mistakes of inadvertence or accident.

In *Wilson* v. *Emmett*, 1 Baldwin, p. 316, 1 Robb, p. 593, the court used the terms "mistake, accident, or *ignorance*."

In *Rubber Co.* v. *Goodyear*, 9 Wall., 733, this court held as follows: "A patentee or his representative in a reissue *may enlarge* or restrict the claim so as to give it validity, *to secure the invention.*" In *McClurg* v. *Kingsland*, 1 How., 202, the court defined what an invention is, as follows: "The invention is the machine and the machine is the invention." In *Wilson* v. *Rosseau*, 4 How., 646, it determined what the thing patented was, as follows: "The thing patented is the invention, so *the machine is the the thing patented*, and to use the machine is to use the invention, because it is *the thing* invented, and in respect to which the exclusive right is secured."

From this it will be seen that in the early cases the thing patented was not for reissue purposes understood to be the device or combination of devices set forth and pointed out in the claim. As patents multiplied, it became necessary that the boundaries of the invention should be more accurately defined; therefore, Congress required each applicant, before he obtained a patent, to point out the particular part or combination of parts which he claimed to be as of his own invention. This is the most difficult requirement of the statute, for the reason before stated, that but few men, if any, are of sufficient information or intelligence to define accurately what is new and what is old, or to draw a specific and clear line between the two, and the most ordinary and common blunder is that of putting into combinations, parts which are unnecessary, and which load down the actual invention, so that the patent truly becomes inoperative, to secure to the inventor that which actually belongs to him.

Proper reissues are ~~not~~ to be encouraged and not discouraged for:

"Accurate descriptions of the invention is required by law, for several important purposes: 1. That the Government may know what is granted, and what will become public property when the term of the monopoly expires;

2. That licensed persons desiring to practice the invention may know, during the term, how to make, construct and use the invention; 3. That other inventors may know what part of the field of invention is unoccupied."

Bates v. *Coe*, 98 U. S., 31.

It is well understood that the strength and scope of a combination claim is in inverse relation to its length. The more parts there are, the weaker the claim is, and a claim is of necessity broader when unnecessary elements of a combination are eliminated. The task of separating these things, and doing exact justice, is a difficult one for patent solicitors, for the Patent Office, and even for the courts, after an exhaustive examination has been made; and it usually happens that until a more exhaustive examination has been made than the time allowed to the Patent Office Examiners permits them to make, that the patentee does not truly and in fact know whether his patent has the boundary correctly drawn or not.

While the courts have, and do, properly, set their faces against attempts to grasp and bring within the possible meaning of the words of a claim that which does not belong to the patentee, equal care should be exercised to give to the patentee that which in fact belongs to him, and, therefore, as frequently stated by this court, each patent must depend upon its own subject matter and its own relation to the prior art, rather than upon any general definition or rule which could be laid down. In the very nature of things, two valid patents cannot be alike.

Legal Conclusions.

We have not thought it advisable to weary the court by a review of the decisions involving questions of reissue law, and we therefore content ourselves by simply stating

the conclusions which we think are properly and necessarily drawn from them, as follows:

1. That the general system of patents rests on statute provisions.

2. That having obtained a patent *under the statute*, an inventor has a natural right to have it corrected or reformed, if inadvertently wrong.

3. That at the common law he has a right to have his patent cover *all* that he has invented in the same machine or same subject matter, whether shown or described in his patent or not.

4. That statutes concerning reissues *are not grants*, but are merely limitations or regulations on the exercise of that right.

5. Congress interfered to restrict the law on this subject, and to regulate the practice, It granted nothing, unless it was the right to divide into more than one patent. § 5, act of 1837; § 4,916, R. S.

Congress, in regulating reissues, cut off:

6. The right to include inventions nowhere shown, described or intimated in the original patent, because it left an open door for fraud; because where there was no description or showing, no man, however skilled in the art, could determine from the patent, what the patentee had or had not invented; and because no foundation had been originally laid for such claims.

7. Also the right to include later inventions, because the reissue, relating back to the original *file date*, gave a fictitious date for such later improvements, and cut off intervening defences, and rights.

As a compensation for cutting off the right to include later inventions, it granted the right to tack on additional descriptions of, and claims for later inventions by their true date.

This right of tacking on was cut off by the act of 1861,

which directed that where they were heretofore allowed, separate patents running full time might be issued; and this change in the law was the main cause of the "flood of patents" since issued.

Concerning the matters which may be resorted to in reissuing, the statute and the decisions include the following:

1. A description in the specification:
   Seymour v. *Osborne*, 11 Wall., 516.
   Corn Planter Case, 23 do., 181.
   Marsh v. *Seymour*, 97 U. S., p. 356.
   Battin v. *Taggart*, 17 How., 74.
   Bell v. *Langles*, 102 U. S., 128.
2. A showing in the drawings:
   Seymour v. *Osborne*.
   Marsh v. *Seymour*.
   Bell v. *Langles*.
3. Things found in the model:
   Seymour v. *Osborne*.
   Hogg v. *Emmerson*, 6 How., 437.
4. Substantial indications in specification or drawings:
   Seymour v. *Osborne*.
   Marsh v. *Seymour*.
   And cases cited on 1st and 2d.
5. Whatever else was fairly *suggested*:
   Seymour v. *Osborne*.

In all of the decisions of this court where reissue patents have been found invalid, such finding has involved some one of the following causes or reasons:

1st. Manifest changes by interpolating claims covering inventions which were after-thoughts designed to cover subsequent *bona fide* inventors.

2d. Worthless patents dug up and enlarged to cover by generalizations valuable inventions of subsequent *bona fide* inventors, who would be unjustly deprived of the fruits of their inventions, if such after-thoughts were allowed to

be covered by general claims drawn in the light of later discoveries.

3d. Reissues of patents which have been allowed to lay idle for years and allowed to be used by the public in the employment of capital and labor to develop them and improve their really inoperative constructions.

Reissues for actual inventions have been frequently sustained when the reissue was had many years after the granting of the original patent.

In reference to the time when a reissue can be had, this court, in *Wilson* v. *Rosseau*, 4 How., p. 688, held as follows:

" 10. That the Commissioner of Patents can lawfully receive a surrender of Letters Patent for a defective specification, and issue new Letters Patent upon an amended specification, *after the expiration* of the term for which *the original patent was granted*, and pending the existence of an extended term of seven years; and that such surrender and renewal may be made *at any time* during such extended term.

"It is thereupon now here ordered and adjudged by this court, that it be so certified to the said Circuit Court."

The law provides a penalty for reissuing, which is the shortening of the life of the original patent, even where the old claims are repeated. No such penalty follows a disclaimer made in the event of having claimed too much. A fair inference would follow that new claims were to be expected when a reissue was had.

We do not understand that the law, as theretofore stated by the courts, has been changed by the recent decisions, commencing with *Miller* v. *Brass Co.*, and at this time ending with *Mahn* v. *Harwood*; that any attempt to change the law has been made except by the introduction of the equitable doctrine of laches, nor has this court reversed its decision in *Wilson* v. *Rosseau*, where it held unanimously that the words of the statute: "Whenever any patent is inoperative or void by reason of a defective specification," meant

that this discovery might be made and the patent reissued at any time up to the last day of its existence, and after an extension.

This court also, in *Powder Works* v. *Powder Co.*, 98 U. S., p. 138, defined "new matter" as follows: "By 'new matter,' we suppose is meant new *substantive* matter, such as would have the effect of changing the invention, or introducing *what might be the subject matter of another application* for a patent."

The important words of this section of the statute have received such construction as leaves them to be well understood, and to do away with the necessity of specially considering them. The words "accident, inadvertence or mistake" have each of them a very wide range, both in their technical and common acceptation.

The doctrine of laches is well understood, and it is never applied in equity except where there are intervening rights, or where some person or party has suffered through the neglect of the party whose duty it was to act. In the abscence of a statute, as explained by the court in *Mahn* v. *Harwood*, there could be no specific time or limit when it applies, and this court, notably in *Clements* v. *Odorless Excavating Co.*, 109 U. S., 641, held that it applied where intervening rights came in within less than two years, and this was undoubtedly a proper application of the doctrine; and in the case of *Mahn* v. *Harwood*, before referred to, the court held, contrary to the holding of the Circuit Judge in this case at bar, that two years was not a necessary limit, but that, by reason of the analogy existing between a two years use, prior to an original application for a patent, and a two years publication or use, by, or under, a patent, in which no claim was asserted for the improvement, was tantamount to a declaration on the part of Congress that an abandonment of two years to the public forfeited all claim for an exclusive right to the improvement so shown or used.

In this case, although a bill was filed, and the case decided before the decision in *Mahn* v. *Harwood*, an attempt was made to explain the delay, yet the court being of the opinion that two years was an absolute bar and a forfeiture of all right to any additional claim, sustained the demurrer and dismissed the bill, as will be seen, principally upon this ground. Under the authorities, we think it clearly appears that the court below erred in dismissing appellant's bill.

In relation to the second point, to wit, the failure of the court to consider the fact that satisfactory reasons had been presented to the Commissioner of Patents for excusing the delay, it will be seen that all that it was necessary to say on this point, is, that if this is not sufficient, or if it is not necessary that the bill should state in direct and positive terms what these reasons were, that should be a matter of exception, and not a matter to be reached on demurrer, and in fact, was not reached by the demurrer, while exceptions were filed excepting to the introduction of any such matter in the bill at all Under the view which the court took of the case, it is not necessary to pass upon these exceptions, and they were not passed upon. But, certainly, there is a sufficient allegation in the bill to enable appellant to make such proofs as he could, and then, and not until then, would the question of sufficiency arise. The bill shows that the Commissioner was attentive to his duty in citing the case of *Miller* v. *Brass Co.*, and in requiring reasons for the delay, and the court could not, upon a demurrer, say that the finding of the Commissioner, that the excuses were satisfactory, was immaterial and irrelevant.

The decision of the Commissioner is at least *prima facie* correct, and cannot be reviewed or set aside without proof showing it to have been wrong.

It is of course assumed that delay in applying for a reissue can be explained and excused the same as delay in any

other matter. In *Turner & Seymour Company* v. *Dover Stamping Company* (111 U. S,. 326), this court animadverts against "a delay of nearly twelve years, *without the offer of an explanation or excuse.*" Refering to its two years suggestion, in *Mahn* v. *Harwood* (112 U. S., 363), it says "that excuse for any longer delay than that should be made manifest by the special circumstances of the case." And in *Hartshorn* v. *Eagle Shade Roller Company* (18 Fed. Rep., 93), where there was a delay of about ten years, Judges Lowell and Nelson say that "under these unusual circumstances, the lateness of the application is explained," etc.

And, of course, if the delay can be explained, it is proper for the Commissioner to enquire into and decide in reference to it whenever the question is presented by a reissue application. As said by Justice Miller, if "the delay defeated the right to the reissue, this was a matter into which the Patent Office should enquire. The duty to do so devolved on it, and the right to decide it necessarily followed. While the dates of the original patent and of the application for a reissue might seem to show an unreasonable delay, this appearance might have been removed by evidence which afforded a full justification for it." *Mahn* v. *Harwood*, 112 U. S., 366.

Now, if the delay can be explained, and it is the duty of the Commissioner to inquire and decide in reference to it, it would seem to follow, as a matter of course, that this decision shall be considered as at least *prima facie* correct. As said by Justice Woods, in reference to the extension of a patent, "while the decision of the Commissioner of Patents is not entitled upon this question to the force of *res adjudicata*, yet it is a determination entitled to the highest respect of the courts, and should not be reversed except upon the most satisfactory proof." *Cook* v. *Ernst*, 5 Fisher, 406.

And in *Spaeth* v. *Barney*, (30 Off., Gaz. March 10th, 1885, 997), where the delay was more than seven years and a

half, and no excuse was shown to have been offered, Judge Colt, overruling a demurrer to a bill, said: "It is not necessary to aver, specifically, the ground on which the original patent was surrendered. The reissue of letters patent by the Commissioner is *prima facie* evidence that such reissue is founded on sufficient cause and is in accordance with law. It is also presumed that the Commissioner acted within his authority under the statute until the contrary is proved."

Respectfully submitted,

L. L. BOND,
EPHRAIM BANNING,
THOMAS A. BANNING,
Counsel for Appellant.

115-87 ✕96

Supreme Court of the United States.

JOHN F. WOLLENSAK,

v.

FRANK A. REIHER.

Nos. 249 and 1242.

SUPPLEMENTAL BRIEF.

A supplemental brief is possibly a work of supererrogation, yet I desire to call attention to a few points in Appellee's brief.

P. 5. The matter here italicised is fully answered by Rule 45, of the "Rules of practice in Equity," which prohibits the filing of special replications.

P. 7. It is here stated that Appellant is the only witness on the point of prior invention. John Wollensak, the father, p. 85, testifies that Appellant had the museum described by him, and on p. 95, Paulina Wollensak testifies in relation to the museum, and to the fact that it was burned in the fire of 1871.

P. 7. The answer here quoted at length, from p. 68, is followed by an answer which shows that the device was completed and put into actual use by Appellant, on some doors belonging to a specimen or museum case, in his private dwelling.

P. 8. Wollensak testifies, as there stated, but on p. 80, he says that he will swear positively that the reproduced cigar box model is correct.

P. 11. The statement here made in reference to the Bayley & McClusky patent, may be misleading, as there is no evidence to show that any attempt was ever made to re-issue this patent, and the record, p. 103, shows that the Bayley & McCluskey patent was cited, and was found not to show or anticipate Appellant's invention.

P. 12. The supposed "dangerous precedent" is founded on a misapprehension of the evidence, as it ignores the glass doors of the museum case in which the invention *was completed and used*, and supposes the prior date, rests solely upon the cigar box model. The use was necessarily private, otherwise another defense might come in.

The general rule on this subject is laid down in *Dixon* v. *Moyer*, 4 Wash. 68, (1 Robb. 324,) where the Court says:

"If the defendant attempts to avoid the patent by showing that the plaintiff was not the original discoverer, the patent will be considered as relating back to the original discovery."

This is an old case, but the rule here stated has been followed as settled law. See: Curtis on Patents, § 342, p. 467.

P. 19. The authorities here cited in support of the demurrer, do not apply with the exception of Walker, § 597, and this section is of equal authority on the point that the excuses for "laches" *can be shown by the evidence.*

The case of *McLean* v. *Fleming*, is founded on a trademark, and has no relation to demurrers of any kind, and the case of *Mahn* v. *Harwood*, while fully discussing the doctrine of laches, does not refer to any question of practice in relation to demurrers.

L. L. BOND,
Counsel for Appellant.

115-87+96

IN THE

Supreme Court of the United States.

OCTOBER TERM.

JOHN F. WOLLENSAK,
Appellant,
vs.
FRANK A. REIHER,
Appellee.

Nos. 249 and 1242.

BRIEF FOR APPELLEE.

CHARLES T. BROWN,
COUNSEL FOR APPELLEE

BARNARD & GUNTHORP, LAW PRINTERS, 44 & 46 LASALLE ST., CHICAGO.

IN THE

Supreme Court of the United States.

OCTOBER TERM.

JOHN F. WOLLENSAK, *Appellant*,

vs.

FRANK A. REIHER, *Appellee*.

Nos. 249 and 1242.

BRIEF FOR APPELLEE.

No. 249.

Complainant brought suit in this case for infringement of the alleged invention described and set out in re-issue patent, No. 9,307, and claimed in the first and third claims thereof, granted complainant, John F. Wollensak, July 20, 1880.

The original patent bears date March 11, 1873, No. 136,801.

The contention on the part of the defendant, as presented by the pleadings and supported by the proofs, is:

"1. In said re-issue No. 9,307, several matters and

"things therein claimed are new and distinct from the said "matters and things set forth, claimed and patented in the "said original patent No. 136,801"; and that as to such new matters the re-issue is void.

2. That there is not disclosed in the patent, under the limitations contained therein and under the Bayley & McCluskey Patent, No. 79,541, July 7, 1868, a patentable invention.

3. That defendant does not infringe complainant's patent, but manufactures an entirely different transom lifter under patent granted him, defendant, April 6, 1880, No. 226,353.

Proofs were taken, and on final hearing the court found for defendant on all the issues presented, and dismissed complainant's bill for want of equity.

I.

Appellee insists that so much of complainant's alleged invention as was described and set out in complainant's original patent No. 136,801, March 11, 1873, and not claimed, was given to the public, or any individual member thereof, by the laches of the complainant, in the long delay before applying for the re-issue (more than five years). The exclusive rights secured to an inventor by a patent are granted by the government to the individual, not on the theory that the invention is the property of the inventor, but as an incentive, a reward, that the many may be benefited by the exertions of the individual. The grant must be construed strictly as against the grantee, like all other grants by government. Hence the inventor

must be diligent to examine, and swift to correct errors or supply deficiencies.

Measured by this rule, the first claim of complainant's reissue falls. But defendant's patent was issued to him before the reissue sued on; hence defendant had, so far as anything claimed in the reissue not claimed in the original is concerned, special intervening rights; even admitting that the broad general language of the broadened claim (claim 1) of the reissue can be grammatically construed to cover defendant's construction.

Complainant makes no contention of this position; but has assumed, throughout this whole litigation, that: "These claims are so near alike that they may be treated "as one, or the case may be treated as resting upon the "third claim."

Complainant's brief, page 2, lines 32–3–4.

The first claim of the reissue, in so far as it covers more than the third claim, is confessedly void.

II.

PATENTABILITY.

Complainant gives the state of the art at the time of his invention, as follows:

"Transom lifters have heretofore been constructed "with a long upright rod or handle jointed at its upper "end to a lifting-arm which extends to and is connected "with the side or edge of the transom-sash, the sash "being opened or closed by a vertical movement of the "long rod. When thus constructed the upright rod is

"liable to be bent by the weight of the transom, owing "to the want of support at or near the point of junction "between the long rod and the lifting-arm." (Printed Rec., 129.)

As a matter of fact the state of the art was much further advanced. In the Bayley and McCluskey Car Ventilator patent "D D^2, two rods, the one arranged to move in "guides E along and above two of the windows, with "which they are connected through the link or connect-"ing rods F, suitably hung therefrom, and the other rod "D^2, similarly arranged to move in guides E^2" are rods performing the same function, (doing identically the same work in the same way) as does the upright rod in complainant's alleged invention; and these rods have guides E E^2 on both sides of the point of junction of the links or connecting rods F, F^2. These links F F^2 are also identical in function and in every detail with the lifting arm of complainant's device. (Bayley and McCluskey Patent opposite page 133, printed Rec., and pp. 134–5.)

Taking the state of the art as described by the complainant in his patent (set out above), and the state of the art in car ventilators, as shown by the Bayley & McCluskey patent, and considering further that the transom lifter and the car ventilator, if not identical, as defendant insists, must at least belong to the same class (that is, a pivoted window out of reach of a person standing on the floor, and therefore moved by a special appliance), the inference is clear there is no invention in transferring to the transom lifter described as old in the specification, the prolongation of the sliding-rod beyond the point of junction with the rod connecting it with the sash, and the placing of a guide thereon.

The force of this reasoning is well understood by counsel for complainant, and by complainant himself, and for this reason the complainant claims, that although the Bayley & McCluskey patent was issued July 7, 1868, and the Wollensak patent (original patent) March 11, 1873; still, Wollensak is prior, in point of time, because he invented his device in the year 1866, although he did not take out or make any application for a patent for nearly seven years after his alleged date of invention.

This manner of avoiding the Bayley & McCluskey patent certainly possesses novelty, whatever may be said of the invention. *The complainant does not set up in his replication to the answer of the defendant (wherein defendant sets up the Bayley & McCluskey patent, and claims that it anticipates the complainant's patent) or in any plea that his invention was made prior to the date the Bayley & McCluskey patent, or that he was a prior inventor to them; nor does he deny that the Bayley & McCluskey patent was, as alleged in the answer, issued and obtained prior to his time of invention.*

UNDER THE STATE OF THE PLEADINGS.

We say that complainant cannot attack the validity of the Bayley & McClusky patent, or show that the complainant's invention was in fact prior in date to the date of the issuing of that patent, for the reason that they have not put it in issue.

And the defendant cannot be compelled to meet an issue not made by the pleadings.

Had the complainant desired to claim that, in point of fact, his pretended invention was prior in date to the in-

vention of, or the issuing of the patent to, Bayley & McClusky, he must have plead that fact when the burden of proof would have been upon him, to have established it if he could.

In commencing this suit, the complainant's claim is that he obtained a patent in March, 1873, with reissue in 1880, and that the defendant had infringed that patent. There was no allegation in his bill in regard to his being prior in point of time as to invention to the date of the Bayley & McClusky patent, nor was there any allegation in regard to the time when he made his invention, so that as the pleading stood at the time the answer was filed, the defendant did not have any information from the complainant's pleading that complainant claimed he had made his invention before the Bayley & McClusky patent; and when the defendant set up said patent in defense, the complainant must set up or plead the fact that he was, *as to the invention*, prior in time, and, not having done it, cannot have the benefit of any testimony in regard to it.

At the time the testimony of complainant was offered (John F. Wollensak's), which could have any bearing on the question as to the actual time of the complainant's invention, the same was objected to by defendant, claiming that the testimony was not in rebuttal of defendant's testimony, and that it was irrelevant, etc.

The testimony was not offered until after the said defendant had closed all his testimony in the case.

It would indeed be a hardship on the defendant to be obliged to meet on the trial an issue not made in the pleadings, and which, of course, he had not met in proof.

The complainant, in order to prove that he had made

and invented the transom-lifter patented by him, at a date anterior to the date of the Bayley & McClusky patent, went upon the stand himself as a witness, *and in fact was the only witness on that point.*

I call the court's attention to the testimony of the witness on this subject. (Page 68 of Record.)

"My first effort was made in the spring of 1866. I "then made a device that *I cannot accurately describe just* "*now; but as near as I can remember*, it was the same as "that described as being old in my patent, and I applied "it to a show-case door, hinged at the top, that used to "be in my room. Subsequently, and during the same "year, I made a model door and transom, being in part "made of a cigar box; the lifting device being made "substantially the same as that described in my "patent, but differing somewhat in the construc-"tion. Instead of passing the upper guides over "the rod—that is, the lifting rod—I slotted that por-"tion of the rod, and held the rod in place with "a screw. The slot allowed the rod to pass up "and down freely—the screw acting as a guide and sup-"port for the upper end of the lifting rod, and also in-"stead of a set-screw, as we use now, for the purpose of "holding the transom in its position at any place desired; "I also slotted the lower portion of the lifting rod, and "used a similar screw, as described for the upper portion, "for the purpose of holding the rod in place and guiding "it, and drilled holes through the rod sidewise of the slot, "and used a pin through the holes for the purpose of "holding the rod in position, the rod being made square "instead of round. I do not remember whether I used "a chain at the time, for holding the little pin from being "misplaced or lost, or whether it was a cord. I believe

"it was one or the other, but with this exception, *the* "*model was as near like the model I now have in my hand,* "*as I can remember.*

"The model I now have in my hand, was made July "22, 1881, from memory, and was made by me."

Witness says that the first device was put in a door in his museum. I made the model the same year. First one had no upper guide. It was made of wood. (Rec., 69.)

That he made the model secretly; *no one knew about it.* It was hidden in the shop and burned up in 1871. *That he never showed it to any one.* (Rec., 70.)

That he talked with Mr. Ellsworth, the patent solicitor, about the patent in 1870. Had the model then. (Rec., 71.)

When I made the model, I applied it to a cigar box. (Rec., 80.)

Never applied to anything but the cigar box. (Rec., 80.)

I never showed it to any one.

Always kept it secreted in my place of business.

Was twenty-five years old at the time of the fire.

Had the model secreted four or five years before the fire. (Rec., 81.)

I changed the place where it was, occasionally.

Had it hid under the floor.

I changed it so many times, so that no one should see it.

Kept moving it all the time.

I put up transom-lifters after the fire, without the prolonged rod and guide. (Rec., 83.)

I put them up after consulting with my partner in spring of 1872.

"The only two that I made were before the fire.

"The one model and the show-case." (Rec., 84.)

The mother of complainant swore as follows:

"Q. Did your son, the complainant, ever say anything "to you about his making a model while you were in the "house on White street?" (Rec., 96.)

"A. He did not say anything about it."

"Q. Did he ever say anything about making an in-"vention relating to transom-lifters or windows, about "that time?

"A. No, I do not remember of it." (Rec., 96.)

The testimony of complainant shows that at the time of the fire, 1871, he was in business alone, and had been sometime before alone, and had employed four or five men, doing locksmithing, etc. Was alone in business from spring of 1872, until he took out patent.

The complainant swore that he made a model, not like the one on the cigar box in 1866, and kept it hid from every one, and never told any one that he had it, nor did he show it to any one; always kept it hid, kept moving it for fear some one would find it for five years.

Gave as a reason that he was afraid of his partner and did not have much money. Had no partner for a year or two before the fire; and had four men at work for him, but did not take out a patent, and was at that time twenty-five years old.

We can but think that all this pretense about the model is a purely imaginary thing.

He says that, as near as he can remember, he made one as stated.

From his own statement the only model he ever made was one not like the one upon which he obtained a patent, but was in an incomplete state.

If his story is true, why was he so secret in regard to his invention? If he says it was of great value why did he wait for six or seven years after he knew of its value before he obtained a patent? To say he could not get the money is too foolish to tell. If he had such a good invention, why, when he was in the transom-lifter business, did he put up the old kind? If he valued it so highly that he was afraid every one would steal his patent, he certainly did not make any to put on the market until he got his patent. If he was afraid some one would steal his cigar box, why not take off the model and take it apart, so they could not see it?

Again, when he had made the one of wood, which he says he used at his house on his museum case, how could he tell or imagine that the rod above the lower grade would bend, if so supported above, when no sufficient trial had been made to demonstrate whether it would bend or not?

He pretends he had no knowledge of transom-lifters until he made his model. The true fact is that he did not make such a model as he says he did when he got out his patent; his specifications set forth the old mode and the defect.

He made and put up the old kind in 1872, and then it was, and not till then, that he had any idea of the exten-

sign of the rod and the upper guide, and he immediately thereafter, in 1873, applied for his patent.

If there was any doubt about his statement about making the model being false, one little incident fully and clearly shows its untruthfulness:

The complainant introduced the file wrappers from the patent office, to show that at the time he made his application for his patent he was met with a rejection by the examiner, on the ground that it was in fact anticipated by Bayley & McClusky, dated July 7, 1868.

And, from appearances, it looked for a time that the patent would be defeated by a re-issue of the Bayley & McClusky patent.

The complainant, by his solicitor, Mr. Ellsworth—whom he had consulted, he says, in 1870, and at a time when he had his model—made a long and voluminous argument before the patent commissioner. But not one word was said, in that argument, about the fact that the complainant had really invented his device two years before Bayley & McClusky had. If the complainant had made the model in 1866, and the invention, as he claims, would Ellsworth—who, according to his theory, must have known it—used that fact in endeavoring to get the patent through by showing what they claim now?

The theory of invention in 1866 is not true; complainant may possibly have had some vague notion about it, and had whittled out a kind of a toy, but no more, even if that.

But say the solicitors for complainant: "He is corrob-"orated in his testimony about making the model." At the same time that they admit that not a living soul ever knew or heard of the model, or knew of its existence;

and in fact the complainant swearing positively that not a human being ever knew that he had made the model or conceived the idea of making the transom-lifter; and when they were asked how he was corroborated, they answer that, because, in the complainant's testimony he swore to the place where he lived, what room he slept in, and what his business was, &c., &c.; and his father and mother told the same story about where he lived, his business, &c., he was corroborated. A witness is not corroborated in material testimony by some witness swearing that he has told the truth in some immaterial matters and things.

It would indeed be a dangerous precedent to establish that a person could support an unpatented prior invention, on his own testimony alone, swearing that he had intentionally kept it a secret for years. Courts have held in many instances that the oath of an interested party uncorroborated in the slightest detail in regard to an invention, is not sufficient to establish a prior invention to defeat a patent granted to a person having no knowledge of the prior invention.

To entitle a person to overcome a patent properly issued, by reason of a prior invention, something more must be done than the mere conception of the thing itself, or the making of some experiments. On the contrary, before it can avail the party, he must have reduced the invention to practical use. Something more must be done than the making of some incomplete model; a practical working machine must have been made.

The reason of the above rule is obvious, "since the "mere conception, while it remains in the mind of the in- "ventor, can add nothing to the world's knowlege; it is a

"matter incapable of being rebutted; and were a party "permitted by mere allegations of conceptions, to estab- "lish a priority of invention, a premium would be held "out for false swearing, against which, however, inven- "tion could have but little security."

To allow the complainant to sustain his claim for priority of invention on his own unsupported testimony, when he declares that it is absolutely impossible for the facts he alleges to be known to any other person, so that the truth might be tested by other or disinterested witnesses, would make it an inducement for a dishonest man, as soon as a patent had been obtained of a valuable nature, to at once file his application for a patent—on the ground of prior invention—and if his own unsupported testimony could control, would have an opportunity of succeeding in his fraudulent scheme.

In considering this case we must carefully consider the nature of the complainant's improvement, and the seemingly small benefit to be derived from what has been added to an old and well-known device (as to this there is no question, as the complainant so describes it) which improvement seems within the practical knowledge of any skilled workman or mechanic.

The fact that the infringement complained of has been secured to the defendant by letters patent notwithstanding the prior patents of complainant, and Bayley & McClusky thereby, so far as the patent office was concerned, fully recognizing the fact that defendant did not infringe on the complainant's rights. It seems to us that the complainant has utterly failed to establish his claim, for the many reasons heretofore given, and that his bill ought to be dismissed.

Admitting all that complainant says concerning the date of his invention as compared with the date of the Bayley & McCluskey patent (not invention), and that the same should be considered by this court, by his own specification, the state of the art at the time of complainant's invention was a transom lifter in all respects precisely similar to that described in the third claim of complainant's patent excepting the guide G′ and the prolonged rod U.

Here are two elements placed on the old transom lifter by complainant, to avoid and correct a defect found by him in practical experience, as he states: "When thus "constructed (the old way) the upright rod is liable to be "bent by the weight of the transom, owing to the want "of support at or near the point of junction between the "long rod and the lifting arm." Was this a new problem presented to complainant and did he solve it in a new way? Why, the bare inspection of the old transom lifter forced upon his mind the idea that guide G was used as a support to the upright rod; was it invention to place another guide upon the upright rod? And was it invention to prolong the rod to place the added guide on the upper side of the fulcrum, or junction of the lifting arm and the upright rod?

Defendant insists not.

Does Defendant Infringe?

The transom lifter admitted to be old by complainant's statement of the art in his specification was, of course, free for the defendant to use; he in common with all the world, could manufacture that transom lifter, or appropriate it as the basis on which to found improvements.

Complainant and defendant had presented to them, as the complainant says, an upright rod lacking in strength, and requiring either enlargement or support. Complainant may be entitled to great credit, and he may not, in thus stating to all who might come after, the difficulties to be overcome in the old transom lifters; but the stating of a difficulty in a machine, however complete and perfect the statement may be, is not a patentable thing.

Any person, then, had the right to use the old transom lifter, or to correct the difficulties thus stated and set out to him by complainant, in any way he saw fit, provided he did not overcome the difficulties in the same manner as did complainant. With this in view, let us examine carefully what was actually done by complainant and defendant.

Complainant, in order to secure what he conceived to be required, prolonged the upright rod and placed an additional guide upon that prolongation.

Defendant secured what he conceived to be required by retaining the exact form of the old upright rod and lifting arm, without changing them in the least; but placing a slotted guide, so constructed as to act as a support, in and by which the upper end of the upright rod should be guided as it was moved vertically upward and downward in the operating of the transom lifter.

The question is simply this: had complainant so appropriated to his sole use, by his alleged invention, the old form of upright rod and lifting arm, that defendant could not use them in exactly the same form and shape complainant admitted they had previously existed; and further, if defendant had the right to use the old upright rod

and lifting arm, absolutely unchanged, had he the right to place a slotted guide upon the upper end thereof?

So far as complainant's patent is concerned, defendant's upright rod and lifting arm are identical (for, with the locking part of defendant's device, complainant has nothing to do, and the upright rod may be considered as stationary in the block), with the old upright rod and lifting arm, defendant has placed upon the upper end of this lifting arm a slotted guide.

This he certainly had a right to do. He had the same right to start from the common ground, the old form of transom lifter, as had the complainant. And so long as he left to complainant his prolongation of the upright rod, that being named as one of the necessary elements in complainant's combination, so long he did not trench upon the complainant's rights. The prolongation of the upright rod is a necessary part of complainant's invention, and this is of itself a change in the old upright rod, and so long as the defendant leaves unchanged the upright rod of the old transom lifter, he does not and can not infringe the patent of complainant, which requires as a necessary part thereof a change of said upright rod.

It follows, too, that if in order to place and use the upper guide of complainant's alleged invention it is necessary to thus change the form of the old upright rod, then any form of guide which allows the old upright rod to be used without change, cannot be identical with or the equivalent of such guide.

It is said that although patentees are entitled in all cases to invoke to some extent the doctrine of equivalents, to protect themselves against mere formal alterations or

substitutions, they are never entitled to do so in any case to suppress all other substantial improvements.

Seymour v. *Osborne*, 11 Wall., 516, 556.
Blanchard v. *Puttman*, 3 Fish, 186.
See *Murray* v. *Clayton*, L. R., 7 Ch., 570.

But it would seem from earlier cases that the doctrine of equivalents is applied in a broader and more liberal manner in favor of one who has discovered a result or function that is new, as well as the machinery that produces, than it is in favor of one who has simply made an improvement in the manner of bringing about a known result.

McCormick v. *Talcott*, 20 How., 402, 405.
Singer v. *Walmsley*, 1 Fish, 558, 572.
Burton v. *Corning*, 2 Fish, 487, 489.

Hence the defendant cannot infringe either the guide of complainant or the upright rod.

No. 1,242.

This appeal has been advanced to be heard with No. 249, because the only question involved in this case is one of the questions involved in case No. 249, and the parties are the same.

The bill avers that claims 3, 4, 5, 6 and 9 of Reissue No. 10,264, December 26, 1882, is infringed by defendant. This patent is a reissue of Patent No. 148,538, March 10, 1874, for improvement in transom lifters.

Both the original patent and the reissue are attached to the bill, and made a part thereof. An inspection shows that more than eight years elapsed between the granting of the original patent and the grant of the reissue.

The claims sued on are all claims not included in the original patent.

The bill sets up as a fact that there were no intervening rights between the issue of the original patent, "and "until long after your orator had consulted counsel and "taken steps toward applying for said reissue," but is silent concerning whether or not intervening rights had accrued between the granting of the original and the application for or grant of the reissue.

The bill further states that there were no intervening rights between the granting of the original patent, No. 148,538 (original of the reissue sued on), and some other reissue, not set out in the bill and not known to defendant, had been obtained by complainant; the language of

the bill being: "No other person, firm, or corporation, "not acting under his (complainant's) authority, ever be- "gan the manufacture, sale, or use of transom lifters con- "taining or embodying said inventions or improvements "until long after your orator * * * had applied for "and obtained a reissue of his previous patent on tran- "som lifters having broader claims than any now con- "tained in said reissue No. 10,264."

Defendant demurs and contends.

I.

That the question of *laches* can be raised by demurrer, and is a good defense to a bill in equity.

The general principles of equity jurisprudence control in patent cases (Revised Statutes, sections 629 and 4921), and the question of *laches* can be raised by demurrer, and is a good defense to a bill in equity.

Walker on Patents, Sec. 597.
McLean v. *Fleming*, 96 U. S., 257.
Mahn v. *Harwood*, 112 U. S., 354.

II.

That no sufficient cause or excuse is set up in the bill for the long delay intervening between the issue of the original patent and the reissue patent (nearly eight years).

III.

"The specification of the reissue upon which the suit "is brought, and the drawings and the descriptions of the "drawings, were substantially the same as for the original "patent. It is apparent, therefore, that the reissue was "not for the purpose of making the original specification "more full, accurate or intelligible, or for the purpose of "eliminating from it what the inventor had not the right "to claim as new."

McMurray v. *Mallory*, 111 U. S., 97.

The complainant admits that the reissue was obtained for the purpose of broadening the claims to cover the invention actually made, though not claimed.

A comparison of the original and the reissue show that the sole purpose of this reissue was to secure broadened claims. Defendant contends that a period of eight years between the issuing of the original and the reissue shows such laches as to require explanation in the bill on the part of the complainant; and

Defendant contends the bill should allege that no intervening rights had accrued at the time of the date of the reissue patent; and should set out the facts, if any there are, on which complainant relies, to explain the laches apparent by comparison of the reissue with original, so that the defendant may either admit them or make issue upon them.

Defendant claims the public became possessed of all invention, if any there was, in the original patent, not specifically set out in the claims, and the failure to claim

dedicated the same to the public, immediately on the issuing of the original patent. And complainant was bound to exercise the greatest vigilance to inspect his patent and if the claims were insufficient, to surrender the same and obtain reissue.

Whatever is well described in the patent is patented, that is, made patent to the public, whether it is claimed by the patentee or not.

Walker on Pat., Sec. 55.

Defendant contends that after description of an invention is given to the public, and not claimed by the inventor, the dedication to the public is complete; the public, or any one thereof, have the right *and have the knowledge*, to use the invention; hence the inventor does not stand in the same position as does the inventor who has never divulged his intention. In the one case the inventor can confer no benefit upon the public; in the other the benefit to the public is equally great as if the invention had just been made. The sole purpose of the patent laws is to stimulate and incite invention by the granting of a limited monopoly; to induce the inventor to make his invention known, and to secure the right to use the invention by the public, after the expiration of the limited monopoly. All the objects sought by the public are attained by the publication of the invention described and not claimed in the original patent. More than that, the public, by the dedication thus made, are not required to forego the use of the invention until the expiration of the limited monopoly the patentee might have acquired by claiming the same, and this right will not be surrendered unless the inventor use diligence in asserting his rights.

Complainant admits intervening rights had accrued

before the date of the re-issue, but claims that there were no intervening rights at some (unknown) time previous, when he obtained a re-issue (not specified) of an original patent (not named) other than the one exhibited with the bill, having broader claims (not on the same subject matter), than does this re-issue.

The statement shows the position untenable.

In *McMurray* v. *Mallory*, cited, this court say: "There "is no doubt that the first three claims of the re-issued "patent of Barker cover the device here described, but "are void, because they are each of them, broader than "the claim of the original patent."

"The art of extending patents" as early as in the case of *Burr* v. *Duryee et al.*, S. C., 1 Wall., 579–582, demanded and received the attention of this court. Mr. Justice GRIER delivered the opinion of the court, and says: "After examining the Boyden machine, the as- "signee pursued the same course which has been com- "mented on in the preceding case. He surrendered the "patent, and had one re-issued with its specification so ex- "tended as to include Boyden's invention. It is not neces- "sary to make further remarks on the art of extending "patents. It may be ranked, *inter in, genuas artes*, and "may have the claim of novelty, if not of usefulness."

"In this very matter of re-issued patents, it has also "been frequently decided that it is a good defense in a "suit on such a patent to show that the commissioner ex- "ceeded his authority in granting it. Such an offense is "established by showing that the re-issued patent is for a "different invention from that described in the original; "inasmuch as the statute declares that it must be for the "same invention."

Whether the application for a re-issue patent is made in reasonable time is a matter of law, which the court may determine by comparing the re-issue patent with the original, and if necessary, with the records in the patent office when presented by the record.

Mahn v. *Harwood*, 112 U. S., 354.

In the case at bar, both the original and re-issue, was before the court, and hence, all the questions involved could be and were raised by demurrer.

The decision of the Circuit court is in direct line with the decision of this court, and we submit, should be affirmed.

CHARLES T. BROWN,
WM. A. MCKENNEY,
Counsel for Defendants.